

No. 22163 ✓

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

JOHN BOYCE, an individual, and
FMC CORPORATION, a corporation,

Appellants and Cross-Appellees,

vs.

EARL R. ANDERSON, an individual, and
FILPER CORPORATION, a corporation,

Appellees and Cross-Appellants.

OPENING BRIEF OF APPELLANTS AND CROSS-APPELLEES

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This action is brought under the provisions of Section 146 of the Patent Act of 1952, Public Law 593, 82nd Congress, 2nd Session, Chapter 950, 66 Stat. 792, 35 U.S.C., Section 146, by plaintiffs as a party dissatisfied with the decision of the Board of Patent Interferences on the question of priority. The Complaint herein was filed April 30, 1962, and proceeded to trial on the basis of the First Amended Complaint herein filed June 11, 1962, Answer of defendants herein filed on or about August 30, 1962, and the Order of March 28, 1966, Transcript of

Record Volume I, pages 108-109 directing that all proofs of both parties on the issue of public use and/or on sale as contemplated in 35 U.S.C. Section 102(b) shall be submitted for the Court's consideration before the submission of proof on any other issues herein, and upon the issues of fact and law defined in the Pretrial Order filed May 26, 1966, Tr. Volume I, pages 119-134.

This appeal is taken from the Judgment of July 7, 1967, Tr. Vol. I, pages 146-147, as purportedly supported by the Findings of Fact and Conclusions of law filed July 7, 1967, Tr. Vol. I, pages 139-145; Appellants and Cross-Appellees Notice of Appeal filed July 26, 1967; and Appellees and Cross-Appellants Notice of Cross Appeal filed on or about August 4, 1967.

Appellants and Cross-Appellees in this appeal urge this Court to reverse the Judgment of the District Court which in effect holds that plaintiffs herein are not entitled to any patent because of prior public use of the invention at a time more than a year prior to the filing date of the application for a patent and also seeks reversal of the Judgment entered by the District Court, based upon the failure of the District Court to determine the issue of priority of invention, the relief sought by plaintiffs in the filing of this action being under the said Section 146, U.S.C. 35.

As a result of said interference a patent was granted to Earl R. Anderson and Filper Corporation, Appellees and Cross-Appellants, Patent No. 3,075,566 (Designation of Record On Appeal, Tr. Vol. I, Page 158, in which the claimed subject matter of the interference and holdings of the Board of Interference Examiners' decision from which this action was instituted was granted.

Hereinafter the parties hereto will be referred to as plaintiffs and defendants, i.e., their positions before the District Court.

JURISDICTION

Jurisdiction is based upon Title 28, U.S.C. Sections 1338 and 1291 as this is an action brought under the provisions of Section 148 of U.S.C. Title 35 in that the judgment entered by the District Court is final in nature in dismissing the Complaint herein, even though based upon an order for a separate trial upon the single issue therein stated of prior public use.

CONCISE STATEMENT OF THE CASE

This action was first commenced in the Patent Office by the Declaration of Interference No. 89173 between application of Boyce Serial No. 664,711, filed June 10, 1957 and the application of Earl R. Anderson, filed August 6, 1956, Plaintiffs' Exhibit 1, Defendants' Exhibit AR, R. 7, Page 689*. That interference before the Patent Office included as the issue of the interference the count or claims:

"Count 1

The method of removing a pit from its cavity in a peach half which comprises; supporting said peach half, applying an arcuate force to one edge of said pit adjacent one edge of said pit cavity, and guiding said pit adjacent an opposite edge of said pit cavity along an arc which is a continuation of the curvature of said cavity."

The decision of the Interference Examiners, Plaintiffs' Exhibit 88, page 1 thereof, R. Vol. 7, 689. The decision of the Board of Patent Interferences is based upon a holding that Boyce (Plaintiff) has not proven that he

* The transcript of evidence before the District Court will herein be referred to as Record or R. followed by the volume and page number where applicable.

conceived the invention of the count or reduced it to practice prior to August 8, 1956, the date of filing of the Anderson application (Exhibit 88, page 17). It was from this decision of the Board of Patent Office Interference Examiners that this action was instituted under the provisions of said Section 146 of U.S.C. Title 35. Based upon this decision the Patent Office granted to Anderson the patent No. 3,075,566. For the convenience of this Court a reproduced copy of the said patent is appended hereto and the said interference count or claim is included in the said Anderson patent as claim 7 thereof. The Judgment of the District Court from which this appeal is taken is purportedly supported by the Findings of Fact Nos. 11, 12, 13, 14, 15, 16, etc. which, in effect find plaintiffs herein in possession of the invention of the said count or claim from February of 1955 through the peach pitting season of 1956 and had, through that period of time, in bringing the invention to commercial perfection, spent a total of \$808,907.66 (Finding 39), Tr. Vol. I, page 145.

In the history of the development of this peach pitter the process of pitting peaches, the subject matter hereof, begins with the conception of the invention by John Boyce as shown by two disclosure sheets dated respectively January 31, 1955 and February 1, 1955, Exhibits 2 and 3, R. Vol. 3, page 299. Immediately following these disclosures of this invention there was performed what is referred to in the record as the screwdriver test, which screwdriver test was in its entirety reproduced before the District Court by plaintiff John Boyce and Paul Curtis Wilbur, R. Vol. 2, pages 216 to 219. This same demonstration had previously been made to defendants herein and as a record of the said demonstrations there was produced and received in evidence Exhibit 96, R. Vol. 4, Page 355.

The screwdriver tests demonstrated the fact that the pit of the peach could be removed in accordance with the method as defined by the count of the subsequent interference. These screwdriver tests demonstrated, however, as is clearly evident from the record before the Court, the problems existent in commercial use of this process and these problems were (a) the problem of yield, and (b) the problem of pit fragments in the peach halves. The yield generally referred to in this brief is the number of cases of peaches which are obtained from a ton of peaches as delivered to the cannery and is the dominant factor in the total cost of production, R. Vol. 3, page 296. Pit fragments must be entirely absent in order to produce an acceptable product, R. Vol. 3, pages 296-297. As shown by the photographs of Exhibit 96 of the screwdriver tests the presence of pit fragments resulting is evident as is also the problem of yield due to the adherence of peach flesh to the pit as removed.

The screwdriver tests, as is true of subsequent development of the method involved also established that the appearance of the peach half produced particularly in the pit cavity was not similar to that produced in other peach pitting methods, R. Vol. 4, page 371.

It having been developed through the screwdriver tests that the method of removing pits was operative and feasible there remained the problem of overcoming the pit fragments and to so improve the method of operation as to make it commercially feasible from the standpoint of yield. The solution to these problems was immediately undertaken by plaintiff FMC and the fact of this continued experimentation was conceded by defendants' counsel up until August 8, 1955, R. Vol. 3, page 302 and R. Vol. 4, pages 351 and 357. The record

shows that during this period of time a prototype was constructed of what thereafter became known as the 300 head, which head was produced in evidence as plaintiffs' Exhibit 15, R. Vol. 3, page 367. The first of these heads, Exhibit 15, was demonstrated to certain canners in a closed padlocked room located in the California Packing Corporation Plant #3 in August and September of 1955 under confidential arrangements, R. Vol. 4, pages 359-360. The primary purpose of this confidential demonstration of this machine was to determine the acceptance of the peach halves so pitted because of the appearance of the pit cavity, R. Vol. 4, page 371. The second purpose was to determine as to whether or not there would be an extensive or limited use of the method, R. Vol. 4, page 371. The third reason was to determine whether or not the considerable additional expenditure would be justified in endeavoring to overcome the problems that still existed of pit fragments and yield, R. Vol. 4, pages 371-372.

As of December 7, 1955 the expenditures on this development had reached nearly \$114,000.00, R. Vol. 4, pages 372 and 375. It was explained to the canners to whom the demonstration was made that if justified, FMC intended to build further prototypes to be sent to Australia to intercept the peach season in the early part of 1956 to carry on further perfection and development of the method and machinery necessary for carrying out the method in the hopes that perfected machines might be developed for use by the canners in the 1956 season.

Such a program envisioned large expenditures and it was necessary for FMC to conduct what the Court referred to as a market survey to determine whether or not such additional expenditures were justified. It

was explained to the canners at these demonstrations which were carried on in September of 1955 that the operation was experimental, not perfected, that the operations were carried on under conditions of confidential disclosure and that FMC contemplated further development of the method and apparatus for carrying out the method in the peach pitting season in Australia in 1956. See Hauptman, Tri-Valley Packing Association, R. Vol. 4, pages 338 to 340, Annotti, Fairview Packing Company, R. Vol. 4, pages 410 to 414, Pogetto, Fruitvale Canning Company, R. Vol. 3, pages 225-227, House, President, Frank M. Wilson Company, R. Vol. 3, pages 249 to 253. Morici, Production Manager of Herschel & Co. (Now Carnation Company), R. Vol. 3, pages 271-274, Rea, President, U.S.P. Corporation, Vol. 6, pages 560-564, Saxby, Manager, California Division of California Packing Corporation, R. Vol. 6, pages 574-581, Richards, Sr., Vice-President and Manager, Bercut Richards Packing Company, Deposition Exhibit 98, pages 44-46 thereof and pages 40-41, Wilbur, R. Vol. 7, pages 678, 679, Vol. 4, pages 357-367, 371-375.

The two prototype heads, Exhibits 15 and 16, after these experimental demonstrations were never used again and were abandoned because of their obvious shortcomings as determined by their attempted experimental use. R. Vol. 5, page 451.

FMC, after receiving a favorable response that such new method of pitting would be used if successfully developed in Australia, went forward with the project and constructed eleven heads, one exemplar of which, after it was modified in Australia, is in evidence as Exhibit 86, R. Vol. 5, pages 451-452. The eleven heads built are illustrated in the photographs, plaintiffs' Exhibits 43 and 44. The eleven heads sent to Australia were built subsequent to the California Packing Corporation Plant

#3 demonstrations and were sent to Australia in the beginning of 1956 and when received in Australia were found to be deficient and not capable of use. Wilbur, R. Vol. 5, pages 461, 462; Wilbur, R. Vol. 4, pages 421-423. Complete records of the Australian testing and experimentation, Exhibits 51 to 56, record the daily progress, Wilbur, R. Vol. 4, pages 423-431. In fact it was stipulated “. . . in Australia considerable number of changes in those pitting heads, in the machinery involved”, R. Vol. 4, page 432. The Court accepted these facts, R. Vol. 4, pages 432, 433 and 434. Wilbur testified to and demonstrated from the exhibits prepared, R. Vol. 5, pages 455-486.

Mr. Wilbur testified to the development, changes made, time periods of such changes, the testing of the different machines produced, and for this purpose produced a chronological report of the work done in this regard, which is in evidence as Exhibit 94, R. Vol. 5, page 491. With reference to this Exhibit 94 and the testimony of Mr. Wilbur, the changes which were made *in the method and apparatus* for carrying out the pitting is graphically illustrated beginning with the screwdriver tests conducted in early February of 1955 and extending through the period of time ending at the end of the 1956 peach pitting season with the development of the final form of apparatus for carrying out the method including the final modifications of the method itself, the showing that the final form of peach developed, i.e., Exhibit 87, R. Vol. 5, pages 465-467, was placed in commercial use in the F.M. Wilson Plant in Stockton in 1957, and was a commercially successful operation, see House, Vol. 3, pages 257, 250. In this respect Mr. Wilbur, throughout his examination of the development of this method, analyzes each and every modification and each step of the method carried on by FMC. R. Vol. 5, pages 455 to 491. It is shown in this re-

gard that the ultimate cost to FMC of this development and experimentation to December 11, 1956, was in the sum of \$808,907.66. R. Vol. 5, pages 447-448.

Faced with an expenditure of this magnitude in eliminating the problems of pit fragments and yield as were apparent from the beginning of the screwdriver tests in 1955 and as we will hereafter show were still existent in the machines placed in experimental use in the 1956 peach pitting season. FMC conducted what was very reasonably termed by the Court, R. Vol. 5, pages 374, 375, as market research to determine whether or not they were justified in going ahead with this project with the contemplated sending of the machine, crew, engineers, and experts to Australia, with a view toward developing a pitting machine which might be used in the 1956 pitting season.

The 1956 pitting season starts clearly within the statutory period of one year prior to the filing of the Boyce application so that what was done in the 1956 pitting season cannot be viewed as a statutory bar within the provisions of Section 102(b), 35 U.S.C. However, evidence as to what was done throughout the 1956 pitting season is set forth completely in this record to show that through that season and until the end thereof when the final solution was finally arrived at in the F.M. Wilson plant in Stockton with the development of the Exhibit 87 head, the problems of yield, pit fragmentation and operation of the pitting head to a commercial point did not exist.

FMC, after the test demonstrations in the California Packing Corporation Plant #3 in San Jose in August and September of 1955, inquired of those of its customers who were previously using the FMC rotary knife pitter as to what quantity of machines they would use in the 1956 pitting season of the type under consideration in

the event that on final experimentation and development in Australia a commercially usable apparatus for carrying out that method was developed. In so doing, in accordance with their custom, they presented leases to the canners with the understanding that the canners would use either the rotary knife pitter or the pitter with the newly developed head if the development in Australia was successful. Wilbur, Vol. 4, page 375. The development, however, did not end until late in the 1956 canning season with the final development of the Exhibit 87 head at the F. M. Wilson Plant in Stockton. The canners were supplied with both knife pitters which do not involve the invention of the count of this interference and heads which were the final development of the Australian experimentation in the 1956 pitting season and these heads were interchangeably used in that season in an effort to bring to final culmination the production of a successful head embodying the method of the count of this interference.

REA, U.S.P. Corporation, R. Vol. 6, pages 559 to 561;

SAXBY, California Packing Corporation, R. Vol. 6, pages 557 to 580;

HOUSE, Frank M. Wilson Company, R. Vol. 3, page 256;

POGETTO, Fruitvale Canning Company, R. Vol. 3, pages 237-238;

MORICI, Herschel & Company, R. Vol. 3, page 273;

HAUPTMAN, Tri-Valley Packing Association, R. Vol. 4, page 335 (in 1955-56 used only the knife pitter); R. Vol. 4, pages 335, 336 (except for placing of a single machine in the Tri-Valley Packing Association Plant for experimental purposes and which was operated by FMC personnel).

SIGLER, Libby, McNeill & Libby, R. Vol. 4, page 397 (used only the knife pitter in 1956); R. Vol. 4, pages 397-398 and 303-304 (except for one 300 type head machine which was used experimentally).

ANNOTTI Fairview Packing Company, R. Vol. 4, page 407 (used only knife pitters).

RICHARDS, Bercut-Richards Packing Company, Deposition Exhibit 98, pages 29 and 41.

It is factual that no canner paid for any use of the pitting heads involving the process or operation of the count of this interference in the 1956 canning season.

REA, U.S.P. Corporation, R. Vol. 6, page 567.

SAXBY, California Packing Corporation, R. Vol. 6, page 574 (used only the knife pitter);

HOUSE, Frank M. Wilson Company, R. Vol. 3, pages 254 and 263;

POGETTO, Fruitvale Canning Company, R. Vol. 3, pages 241-242;

MORICI, Herschel & Company, R. Vol. 3, pages 290-292;

SIGLER, Libby, McNeill & Libby, R. Vol. 4, pages 335-336 (except for one experimental machine used FMC knife rotary pitters); R. Vol. 4, pages 403-404 (didn't use the torque or rotary pitter);

ANNOTTI, Fairview Packing Company, R. Vol. 4, page 407 (used only a knife pitter);

RICHARDS, Bercut-Richards Packing Company, Deposition Exhibit 98, pages 41, 43, 46, 47 (used and only paid for knife pitters).

In fact the record shows clearly that all canners were in a position of trying out the new heads, changing the

heads back to the knife pitters and that FMC in this development kept a crew of engineers, operatives and in fact executive personnel in the canneries at all times during the 1956 pitting season in an effort to bring this development to a successful culmination. It is shown by the record that the heads embodying the use of the method of the count of this interference were under constant revision in each of the canner's plants throughout this 1956 season. The heads were breaking down due to further pit jamming and pit fragmentation, they were under constant change, development, reconstruction and replacement, and for this purpose a constant crew was kept in each plant.

The District Court recognized the proofs offered in this regard, R. Vol. 6, pages 627, 628. Each of the canners testified as to their understanding of the interchangeability of the heads from the knife pitter to the torque type head, i.e., the 300 head, and testified that they understood that they would have pitting machines for the 1956 season and could and would use the old knife pitters in the event of the failure of the Australian venture to bring the new torque pitter to a point of commercial operation. In this regard each of the canners testified with respect to the 1956 operations, i.e., the testing thereof, in their canneries, the failure of the machines to be commercially operable, and the crew of mechanics, engineers and personnel present during the testing. During this period of time FMC had ten different heads, i.e., ten different kinds of heads which were color coded under experimentation. Wilbur, R. Vol. 5, pages 538 to 544. Each of the canners testified that such operations were experimental and were so looked at by them. Each of the canners testified that they made no payment for their operations in the 1956 season where the new form of head was attempted to be used,

even to the extent of not paying for any use of the knife pitters where the extensive experimentation was undertaken to bring the torque 300 heads to successful development and in fact the testimony was that they had no records which enabled them to determine at any time as to whether they were using knife pitters or the 300 torque pitters in pitting the peaches.

Two of the canners, i.e., FMC's principal and largest customers, Libby, McNeill & Libby and California Packing Corporation, upon being advised by Mr. Wilbur of the extent of the development, used in their commercial operations only knife pitters with the exception of Libby's experimentation with one head. Each of the canners who signed a lease with FMC for pitters for use in the 1956 season understood the interchangeability of the knife head and that they would be supplied with knife pitting heads to use in their commercial operation in the event of failure of the Australian project to bring the new torque 300 head to a point of commercial applicability. Not only did FMC bear the entire expense of this undertaking, but they lost all revenue even for the use of the knife pitters in the canneries where this experimentation was conducted in the 1956 season. This loss of revenue is not included within the over \$808,000.00 cost of this development heretofore referred to. Wilbur, R. Vol. 5, pages 499-502. FMC is recognized as a very large corporation and it is frankly stated, on inquiry by the Court, that this undertaking was the largest gamble ever undertaken by FMC in an effort to develop this method to a point of successful culmination. Wilbur, R. Vol. 5, pages 494-495.

The policy of FMC with respect to filing of patent applications is not to rush to the Patent Office with the filing of applications on untried and unproven develop-

ments but has been at all times, as shown by this record, to wait with the filing of an application so that the applications when they are filed will set forth a proven successful development of the mental concept to a point of commercial success and applicability. FMC's policy in this regard is not to file patent applications to have patents issued to them until the invention is perfect and properly tested and until they can set forth in that application fully and completely the best known mode which they have been able to determine of carrying out the invention. Wilbur, R. Vol. 3, page 326.

Research and development in this field has been conducted cooperatively for many years. In carrying out this cooperative research machines, processes or devices when brought to a stage of possible demonstration have been placed in canneries under precisely the same conditions as hereinabove outlined in perhaps all stages of such development and for the same purposes as hereinabove demonstrated. It is recognized also that dependent upon the type of development under consideration and the product dealt with in order to bring the development to a point of successful consummation multiple installations are required. It has long been recognized that control tests under the auspices of experts and engineers do not give a reliable result. Wilbur, R. Vol. 3, page 318. Although the procedure followed in this case was unusual because of existing practices in the art the magnitude of the venture undertaken and the very complexities which became apparent in overcoming the problems of pit fragments and yield made this procedure necessary to bring to perfection the method and the apparatus for carrying out the method before that method could be competitive with existing methods of removing pits from peaches. R. Vol. 5, pages 494-497.

In the peach pitting field many varieties of peaches are processed in several different territorial regions and under varying conditions and even tests conducted by engineers and under precise conditions of control on one or more of such varieties experience has shown cannot be relied upon. R. Vol. 3, pages 317 to 325.

There can be no serious dispute with respect to the foregoing statement of facts of this case and specific findings with reference thereto were adopted by the Court as findings 11 to 22, inclusive, and findings 27 to 37 inclusive, and that experimentation and testing by FMC continued to the end of the 1956 pitting season resulting in a total expenditure of \$808,907.66 is also set forth in Finding 39.

It is fundamental and is in fact admitted that until a practical way of using the method was developed, the method was of no use, that a method and the mechanism to carry out the method are in fact inseparable. R. Vol. 4, page 438.

In the trial of this cause the Court permitted counsel for defendants to introduce evidence through the reading of depositions where there was no compliance whatsoever with the Federal Rules of Civil Procedure with respect to the signing, presentation of the deposition to the witness for correction, waiver or corrections, or waiver of signature, where the depositions were not signed before a notary, where it was shown that the witness had requested the opportunity to read and correct his deposition before signing, and where there was no notice of filing or reliance upon the deposition filed with the Court. In this cause there was no notice given by defendants of the filing of the depositions taken as required by Rule 30(f)(3). There was no submission of the depositions to the witnesses for changes before signing as required by

Rule 30(e). In fact the witnesses were never given an opportunity to even read their depositions. There was no waiver of signatures. There was no refusal to sign. In fact there was no opportunity given the witnesses to sign their depositions. The total disregard of the rules with respect to the depositions was duly objected to by counsel for plaintiffs. The particular deposition which was read from over the objection of plaintiffs' counsel was the deposition of Clifford Carlton Wilson. There was no stipulation with respect to the taking of this deposition or as to the waiver of reading or signing the deposition. The record with respect to this matter is contained in R. Vol. 1, page 96, to R. Vol. 2, page 115. The ruling of the Court after the objection was stated is contained at R. Vol. 2, page 115.

The same objection was made and overruled with respect to the reading from the deposition of Mr. Wilbur and where it was specifically shown with respect to that deposition that the witness requested the opportunity to read his deposition to correct it, and to sign it personally. The ruling of the Court with respect to the Wilbur deposition is found at R. Vol. 2, page 130.

SPECIFICATION OF ERRORS

1. The District Court erred in finding that the large number of Model 300 machines and the number of leases involved in FMC's leasing program for the 1956 peach pitting season, as well as the circumstances under which such machines were placed for use, requires a finding that the plaintiffs did intend to and did commercially use such machines.

2. The District Court erred in concluding that plaintiffs placed the invention in issue in public use and on sale more than one year prior to the filing of their application

for Letters Patent Serial No. 664,711 within the meaning of 35 U.S.C. § 102(b).

3. The District Court erred in finding and concluding that plaintiffs herein are barred from receiving a patent for the invention set forth in application Serial No. 664,711.

4. The District Court erred in limiting the issues to the issue of public use and/or on sale to be heard at the trial of this cause within the provisions of 35 U.S.C. § 146.

5. The District Court erred in failing to find that all activities engaged in by plaintiffs prior to June 10, 1956, were experimental in character and did not constitute a public use or the placing upon sale of the invention in issue prior to said date of June 10, 1956.

6. The District Court erred in failing to find that plaintiffs herein continued beyond June 10, 1956, in experimentation of and to bring the method defined by the single count of the interference to perfection where the same was susceptible to satisfactory cannery operation and that the plaintiffs' activities in this regard continued through experimentation into the 1956 canning season.

7. The District Court erred if in fact it did base its Conclusions of Law and Judgment herein upon the installation of Model 300 machines in FMC's customer's cannery plants during the 1956 cling peach season, thus constituting public use and/or placing on sale of the invention in issue within the meaning of 35 U.S.C. § 102(b).

8. The District Court erred if in fact it did rely upon the placing of Model 300 machines in use during the 1956 clingstone peach season and that several of the

customers reported the tonnage of peaches processed on such machines and were presented in due course with lease rentals and that some paid rentals due FMC under their leases as constituting plaintiffs placing the invention in public use or on sale for more than one year prior to the filing date of application Serial No. 664,711 within the meaning of 35 U.S.C. § 102(b).

9. The District Court erred in failing to find that the extended activities of FMC in carrying out its experimentation and testing of the pitting devices to the end of the 1956 peach pitting season, amounting to \$808,907.66, established the continued experimentation and testing of pitting devices to bring the method in issue to perfection within the statutory one-year period within which the application Serial No. 664,711 was filed in the United States Patent Office within the meaning of 35 U.S.C. § 102(b).

10. The District Court erred in admitting into evidence depositions of or portions of the depositions of witnesses where it was shown that there was no compliance with or waiver of provisions of Rules 30(e) and 31(c) of the Federal Rules of Civil Procedure and that the witnesses have not signed the depositions or that signature thereof was waived. The said depositions were the depositions of Clifford K. Wilson, Paul C. Wilbur, and John Boyce.

ARGUMENT AND LAW APPLICABLE

It is the position of Appellants that the District Court has erred in this case primarily with respect to what constitutes prior public use under the provisions of Section 102(b) of 35 U.S.C. This section provides:

“A person shall be entitled to a patent unless —

. . . .

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, . . .”

It is secondly the position of appellants in this matter that the District Court erred in its order limiting its determination on the trial of the issues of this matter to the question of proof related to the element of prior public use and in this respect has confounded the issues here and as hereinafter will be pointed out has left standing a patent, presumably valid, the effect of which is to suppress invention and development in this important field and where admittedly that patent is being used by Appellee Filper Corporation for that sole purpose of suppressing competition and development in this field, Filper's position in this respect being amply described by the District Court as a dog in the manger. R. Vol. 5, page 506.

It is the third position of the appellants herein that with respect to the issue of prior public use from the variant admissions made by the parties before the Court and the fact of continued experimentation and development, the District Court erred in the application of law with respect to what constitutes prior public use. The leading case upon this issue is *Elizabeth v. Pavement Co.*, 97 U.S. 126 to 144 (October 1887). This case establishes the rules with respect to what constitutes prior public use as differentiated from experiment as follows:

“ . . . The use of an invention by the inventor himself, or of any other person under his direction, by way of experiment, and in order to bring the invention to perfection, has never been regarded as such a use. . . .” 97 U.S. 134.

and establishes further the rule that there is within the policy of the law not a race to the Patent Office. Thus, the Supreme Court in the *Elizabeth v. Pavement Co.* case states:

“It is sometimes said that an inventor acquires an undue advantage over the public by delaying to take out a patent, inasmuch as he thereby preserves the monopoly to himself for a longer period than is allowed by the policy of the law; but this cannot be said with justice when the delay is occasioned by a *bona fide* effort to bring his invention to perfection, or to ascertain whether it will answer the purpose intended. His monopoly only continues for the allotted period, in any event; and it is the interest of the public, as well as himself, that the invention should be perfect and properly tested, before a patent is granted for it. . . .” 97 U.S. 137.

These statements of both law and policy as thus announced in 1887 by the Supreme Court have not been changed since that pronouncement and remain the law and policy with respect to such matters today.

In the *Elizabeth v. Pavement Co.* case the patent related to a roadway formed principally of blocks arranged to form spaces of about one inch in thickness between the rows of blocks. (97 U.S. 137). The facts with respect to the asserted public use in that case were that the inventor laid a roadway which was in public view on Mill-dam Avenue in Boston in 1848 which was probably used for a space of six years before his application for a patent (97 U.S. 133). This was a toll road. The section of pavement or roadway was about 75 feet in length. It was stated was placed by him where it was in order to see the effect upon it of heavily loaded wagons on the varied and constant use and also to ascertain its durability and liability to decay.

97 U.S. 133. The inventor, Mr. Nicholson examined the pavement almost daily, walking over it with cane in hand and making particular examination of its condition and made numerous inquiries with respect to its reception by people and at the same time made the statement that this was his first experiment with the pavement. 97 U.S. 133. The severity of the test made of the road came about from the starting and stopping of heavily loaded wagons. It was found the result of the whole being that Nicholson merely intended this piece of pavement as an experiment to test its usefulness, its public acceptance, and durability, 97 U.S. 134.

This Court in *Cataphote Corporation v. De Soto Chemical Coatings Inc.*, 356 F.2d 24, 148 USPQ 527, decided February 8, 1966, did not deviate in its opinion in that case from the principles set forth above as derived from the *Elizabeth v. Pavement Co.* case *supra*. In the Cataphote case the Court stated at page 26, Footnote 2:

“The trial court was undoubtedly influenced in his conclusion these were not experimental installations, because of the paucity of testimony that anyone on behalf of Cataphote had at any time inspected the results of pavement use.”

Before June 10, 1956, i.e., more than one year prior to the filing of the Boyce application the only public exhibition or use that could possibly constitute a public use within the requirements of Section 102(b) of 35 U.S.C. was the demonstrations made in August and September of 1955 to the canners. These demonstrations were of two prototype heads, Exhibits 15 and 16. It was recognized that these devices so demonstrated were not susceptible of commercial operation. In answer to a specific question in this regard Mr. Paul Rea, president of U.S.P. Corporation, which operated the Drew Canning Company

Plant in 1955, testified with respect to the experimental operation conducted in that cannery in 1955, which was conducted under the auspices of FMC personnel:

“Q. Would you state whether or not it was a machine adaptable for commercial operation at that time?

A. In my opinion, it was not.”

R. Vol. 6, page 560.

In this regard the Court found, Finding 19:

“19. The demonstrations made of Exhibits 15 and 16 to the canners in August and September of 1955 was not such that the machines demonstrated were believed to be capable of acceptable cannery operation.”

This fact was recognized by FMC personnel and to all those who witnessed these demonstrations in 1955 and it was made known that the demonstrations were experimental. Thus, the Court adopted Finding 16 which reads:

“16. The demonstrations made to the canners of Exhibits 15 and 16 in August and September of 1955 were conducted and controlled by FMC in a closed, locked room at California Packing Corporation Plant #3 in San Jose, and it was explained that the project was experimental, was not perfected and that FMC contemplated the necessity of further perfection and that it intended to send a crew of engineers and technicians to Australia to intercept the peach season in Australia in 1956 to carry on further experimentation looking toward perfection of the machines demonstrated, with a hope that it might have machines perfected for operation in the 1956 peach pitting season.”

Not only is this finding factually correct, it was conceded during the taking of testimony in this matter that the demonstrations thus made did not constitute a public use:

“MR. LYON: Your Honor, there is no case cited and no case of record which I have ever been able to find that any court has ever held that a demonstration of a machine or a method made in confidence under experimental conditions, under closed room conditions, ever constituted a prior public use.

THE COURT: I wouldn't think you would find such a case and I don't think that the defendants, in urging their position, have adopted any such theory. Were this case to rest solely upon the demonstrations under the conditions described by Mr. Wilbur, I would say that the preponderance of evidence would be consistent with the idea that the experiments were continuing and the device was in the process of being perfected to the degree expected or desired by FMC. That isn't the commercial exploitation that the defendants rely upon, as I understand their briefs. They rely upon the placing of orders and the delivery of equipment which must have been manufactured in anticipation of use of that equipment during the 1956 packing season. Am I in error in that?

MR. FOSTER: No, that is essentially correct, Your Honor. The demonstration referred to by itself is certainly not proof of public use.

...”

R. Vol. 4, pages 368-369.

These were the only demonstrations or use of any kind conducted prior to June 10, 1956.

The purpose of these demonstrations made in 1955 prior to the statutory date of June 10, 1956, do not by any stretch of the imagination fall within the prohibition of section 102(b), 35 U.S.C. In fact, there is not any recited case which prohibits the exhibition in confidence of even a completed fully operative commercial machine which is still in the experimental stage and where it is an established fact, as it is here, that the primary purpose of such demonstration was to determine whether or not, if such machine and process could be brought to the point of commercial applicability, that those invited to see the machine and process would in fact use such method and machine. Every element essential to the Court's finding and the concession made by defendants' counsel that these activities did not constitute a public use, was present. There is no prohibition within the provisions of the Statute against any one making such a demonstration for the purpose as here established of determining whether or not the invention would be used sufficiently by the art to warrant the recognized continued large expenses necessary to see, and to use the words of the Supreme Court in the *Elizabeth v. Pavement Co.* case, *supra*:

“ . . . that the invention should be perfect and properly tested, before a patent is granted for it”
(Page 137).

And as said also in *Elizabeth v. Pavement Co.*:

“ . . . Nicholson did not sell it, nor allow others to use it or sell it. He did not let it go beyond his control” (Page 136).

Was it unreasonable and did it fall within the condemnation of Section 102(b), 35 U.S.C., for FMC to determine the extent of possible use of the invention by the canners to whom that demonstration was made

in confidence? The answer to this question is obviously no. As explained by Mr. Wilbur, without such determination and facing the very large expenditure necessary to bring this invention to perfection, if it was found that the invention would be unacceptable to the canners the project would have been dropped.

“Q. What was the purpose, or purposes, if there was more than one, of taking the canners to see this machine at Cal Pac Plant No. 3?

A. There were two purposes, Mr. Lyon. First of all, this method of pitting produced a new appearance to the pit cavity which was not similar to the appearance in any other peach-pitting method, and therefore the first requirement was to determine whether this appearance would be acceptable to the major canners in California who are our customers.

The second purpose was to find out whether this machine might be used—this method of pitting peaches might be used extensively or only to a limited degree.

Q. And did you get expressions of opinion of different canners with respect to this?

A. Yes. Most of them thought the appearance was acceptable, but there were objections to several elements, the presence of fragments and some of the cut surface appearance of the peach.

Q. Why were you interested in getting these expressions of opinion?

A. Because we don't sell peaches and we have to sell to people who have to face the brokers in the market and would know whether or not this appearance might meet with disapproval.

Q. Was this expression of opinion related in any way to a determination of whether or not you would carry on your experimentation?

A. I think obviously, Mr. Lyon. If they considered that the peaches were unsatisfactory in appearance, we would have stopped the work at that time. We had already spent very considerable sums in this experimental work and were faced with the expenditure of much larger sums to carry it on through the next phases."

R. Vol. 4, pages 371-372.

The record in this case and the Findings of Fact establish conclusively that there was in fact no device in existence before June 10, 1956 (the critical date) which was capable of commercial operation to carry out the method defined in the count of the interference. (Findings of Fact 14, 15, 16, 19, 27, 28, 29, 31, 32, 33, 36, 37, and 39).

Findings of Fact 14, 15, 16, and 19 are fully supported by the evidence and no contrary position is possible in view of defendants' concession, R. V. 4, pages 368-369. These demonstrations were the only uses of any device of any kind had before the critical date in which there was any participation of any kind by any person outside of appellants.

In the case of *Amerio Contact Plate Freezers, Inc. v. Belt-Ice Corporation et al.*, 316 F.2d, 459 (1963) it was held that where there was no complete perfected device in existence before the critical date there was *no* public use. In the *Amerio* case the facts were: The critical date was May 23, 1951 (316 F.2d 461). As early as September and October 1950 a mock-up of a machine embodying the essential features of the Knowles invention, which

was operable to demonstrate the invention, was made (461-462). This mock-up was only a model and was not capable of freezing packaged foods (461). Two machines were constructed for Evergreen Frozen Foods Co. and one such machine was assembled by May 15, except for the installation of the freezer plates. There was no question remaining with respect to the operation of such freezer plates in the machines so constructed for Evergreen (461). The two machines thus constructed for Evergreen were delivered on June 19 and 21, 1951, within the critical date, and operated successfully (462). Prior to the critical date in this *Amerio* case, namely on January 30, 1951, Belt-Ice quoted to Evergreen a fixed price for two fifteen-station Knowles automatic package freezers embodying the invention (462-463).

In the *Amerio* case the invention was completely disclosed to Evergreen before this fixed price quotation. There was no assertion of further testing or experimentation at the time of that quotation (462). Parts of the machine were ordered at the approximate time of the fixed price quotation (462). The quotation was made conditional, i.e., "if they could finance them" (463). The final agreement of purchase meeting the condition of finances was not agreed upon until June of 1953, within the critical period (463).

This Court, in considering the foregoing evidence with reference to the "on sale" provision of Section 102(b), U. S. Title 35, affirmed the District Court, holding that there was no public use or on sale within the provisions of Section 102(b) and further held that there was no contract between the parties prior to the critical date of May 23, 1951, stating:

"The latter facts are sufficient to distinguish every appellate decision, involving an invention incorpo-

rated in an article for sale, upon which appellant relies in attacking this conclusion of law. Those are all cases where, prior to the crucial date, there was an offer or a contract to sell an article or apparatus embodying the invention, and at least one fully-operative article or apparatus of that kind was completed prior to the critical date." (464).

As heretofore pointed out, the prototypes made by FMC and demonstrated in August and September of 1955 to the canners was not capable of commercial operation. No further use was ever made of those prototypes and FMC, consistent with their advice given to the canners that the operation they observed was experimental, thereafter built further devices for testing and it is shown in this record that those devices, when they arrived in Australia, were also incapable of operation and did not overcome the problems of yield and pit fragmentation. The testing in Australia and the building of the new head in Australia also failed to produce a machine capable of commercial operation and although heads of this character were delivered to the canners in 1956, after the critical date, they also proved incapable of satisfactory commercial operation in the canneries. This record conclusively establishes the continued experimentation throughout the 1956 canning season and establishes the conditions under which such experimentation was carried out through FMC personnel in these canneries.

The record establishes that in the 1956 season there were ten distinctly different types or constructions of head under testing which were color coded so as to enable a determination to be made distinctly of the operations of these different types of machines. Plaintiffs' Exhibit 61. The record further establishes the fact that these canneries in which these testing operations were being per-

formed, converted back and forth during these testing operations from the knife pitter to the 300 head and from the 300 head back to the knife pitter so that it was not possible at any time during this trial for any witness to state what particular pitter was being operated in any of the canneries at any particular time. That the experiments of FMC continued through the 1956 canning season was stated by the Court and conceded by defendants' counsel:

“THE COURT: I don't think there is going to be any argument made by the defendants that work on these heads did not continue right through the 1956 peach canning season. The fact that all the witnesses have described mechanical difficulties encountered during the 1956 season will require that to be a finding of fact in this case. And certainly the volume of engineers and machinists who were placed in both the Fruitvale Canning Company and in the Stockton plant and in the other plants would necessarily indicate that difficulties were encountered by FMC, and during that season they were trying to produce a more satisfactory or sophisticated machine. But if those things are not really in question, I don't know as we need too much testimony to establish them.

You don't question any of that, do you, Mr. Foster?

MR. FOSTER: No, that's conceded, Your Honor.”

The sole Finding of Fact before this Court which would support the Conclusion of Law that the invention was placed in public use prior to the critical date is Finding of Fact 40 which reads:

“40. The large number of Model 300 machines and the number of lessees involved in FMC's leasing program for the 1956 peach season as well as the circum-

stances under which such machines were placed for use requires a finding that Plaintiff intended to and did commercially use such machines.”

This Finding of Fact is clearly indefinite as to what it actually finds. It is apparently related to the use had of the large number of Model 300 machines which were placed in the canneries during the 1956 peach pitting season. This peach season did not start until July of 1956 and no Model 300 machine was delivered to any cannery until July 1956. Findings of Fact 36 and 37. The machines placed in operation after July of 1956 were like Exhibit 86, i.e., the last of the machines or pitters tested in Australia during 1956.

Finding of Fact 37 finds that the progress and development of the pitter embodying the invention and for carrying out the method was such that

“ . . . it was apparent that those machines did not overcome to a satisfactory degree the problems of yield and pit fragmentation.”

All these operations, as referred to in Findings 36 and 37, were within the critical period so that other than as bearing upon the overall picture of continued experimentation and development to bring the invention to the degree or perfection referred to the *Elizabeth v. Pavement* case of the Supreme Court, these findings may be considered as entirely immaterial because they refer to operations carried out within the statutory period and after the critical date. If it is this 1956 peach pitting season operation to which Finding of Fact 40 relates it obviously cannot support the Conclusion of Law that the invention was placed in public use prior to the critical date within the meaning of Section 102(b).

What was the intent of plaintiffs in these transactions? The intent is conclusively shown and it can hardly be

argued to the contrary within the findings adopted and the concession made, that FMC, plaintiff herein, had at all times advised every one of the fact and necessity of, and that they were actually at all times endeavoring, by continued experimentation, testing and development, to bring the peach pitter in question to a degree of commercial success where it was actually susceptible of commercial use. This intent the record clearly shows was related to the fact of the tremendous expenditures being made by FMC to bring this method to a point where it might be commercially used. Finding of Fact 39 affirms this experimentation and testing of the pitting devices up to the end of the 1956 pitting season. The fact that there was expended in this program the sum of \$808,907.66 as found by Finding of Fact 39 and also the request for appropriation made in the FMC organization, Exhibits 67 and 102, clearly confirm plaintiff FMC's intent in this regard. Exhibit 67 is a request for additional appropriation to develop the project and is dated as recommended by witness Paul C. Wilbur on July 15, 1956, and significantly states:

“ . . . Some major design modifications, as well as numerous minor design modifications need to be tried experimentally.”

It establishes also the history of this development and outlines in some detail the further modification, experimentation, and study program required even as of that late date. Significant in this regard is also Exhibit 68 which is a request for additional appropriation with respect to this project dated by the date of recommendation by plaintiff John Boyce of 12/13/55 and which appropriation was directly related to the construction of eleven heads which were sent to Australia for use in the Australian 1956 season and which establishes:

“ . . . Certain modifications are necessary on these heads for successful commercial operation and improving the pitting appearance; . . . ”

The appropriation made by FMC for closing this project is shown at R. Vol. 5, 446.

All of this expenditure by FMC was, as shown by the testimony of Mr. Wilbur, charged to research and development expense. R. Vol. 5, 449-450.

The only activity which took place prior to the critical date of June 10, 1956 to which Finding of Fact 40 has any reference is the leases entered into by FMC, as the large number of Model 300 machines referred to in this Finding did not come into existence until within the statutory period. It may therefore be, although the Finding of Fact 40 does not so state, nor does any Finding of Fact or Conclusion of Law establish it, that the basis of the District Court's ruling is within the “on sale” provision of Section 102(b). A finding which is so indefinite as Finding 40 certainly is not binding in any way upon this Court. Frankly, appellants here are at a loss to understand the meaning of Finding 40 or upon what it is based with respect to the Conclusions of Law drawn therefrom or with respect to the other findings adopted by the District Court.

It is significant in this regard that one instance of prior public use is sufficient to defeat a patent within the provisions of Section 102(b). The number of such instances is therefore immaterial.

Examination of the record with respect to the leases conclusively establishes the following facts:

1. That the leases were of standard form;
2. The leases were primarily for rotary peach pitters;

3. They were uniformly for delivery of peach pitters for use by the canners, i.e., lessees, during the 1956 peach pitting season and the term of the leases was from July 1, 1956 to November 30 of the same year;

4. They called for delivery of the pitters on or about July 1, 1956. Defendants' Exhibit AB-12;

5. The leases were conditional with respect to any specific type of peach pitter;

6. The leases were conditional as established through the testimony of each of the lessees that they were entered into with the understanding that the No. 300 peach pitters called for were experimental and the delivery of that type of head was entirely dependent upon the progress of development thereof during the Australian peach pitting season and the successful development of that machine prior to the 1956 pitting season for commercial operation; and

7. The leases were entered into as is uniformly true of the testimony of the witnesses, upon their understanding of the fact that the knife pitter was interchangeable with the 300 pitter and with the firm understanding of all parties that if the 300 pitter was not successfully developed the knife pitter would be employed.

It is thus established that if this leasing activity or this offering for lease of the pitters was relied upon by the District Court in support of its Finding of Fact 40 it is on all four's with the "if they could finance them" provision of the offering for sale of the freezers at a stated fixed price in the *Amerio* case. The *if* in this case, as established through the testimony of the lessees, was the condition that the machines be brought forward during the further research and development period to

a point where they could be commercially operated, which condition this record establishes was not met by the Australian venture. Section 1441 of the Civil Code of California establishes that viewed as a contract, that contract was void. Section 1441 of the California Civil Code provides:

“IMPOSSIBLE OR UNLAWFUL CONDITIONS VOID. A condition in a contract, the fulfillment of which is impossible or unlawful, within the meaning of the Article on the Object of Contracts, or which is repugnant to the nature of the interest created by the contract, is void.”

This provision has been construed by the Supreme Court of California in *Autry v. Republic Productions, Inc.*, 30 Cal.2d 144 at 148 (1947), where in dealing with the doctrine of frustration which is particularly applicable here and applicable under the Code Section above referred to, the Supreme Court stated:

“This Court has recently considered the history and nature of the doctrine of frustration as an excuse for nonperformance. (*Lloyd v. Murphy*, 25 Cal.2d 48 [153 P.2d 47].) There it was pointed out (at p. 53) that although the doctrines of frustration and impossibility are akin, frustration is not a form of impossibility of performance. It more properly relates to the consideration for performance. Under it performance remains possible, but is excused whenever a fortuitous event supervenes to cause a failure of the consideration or a practically total destruction of the expected value of the performance. . . .”

In this case the event which intervened and upon which the contracts or leases were dependent was the perfection of the No. 300 head so that it was applicable for cannery operations during the 1956 canning season. The record

here conclusively establishes that this condition of the understanding of the parties to the contract was not met prior to the critical date of June 10, 1956. The lessees were advised prior to the 1956 canning season that the conditions had not been met.

It is established through the testimony of Mr. Saxby of California Packing Corporation that he was advised by Mr. Wilbur that the development had not been proceeded to the point of producing a satisfactory machine and that the machines were not going to be available and the result was that California Packing Corporation exercised its election and option to use the knife pitters throughout the 1956 pitting season. Mr. Saxby testified:

“Q. Isn’t it true that the determination was made and (sic) not to use the 300 heads before the season started by California Packing Corporation?

A. These — I think I can recall the conversation this way: The season was getting along — approaching, rather, not getting along. When I speak of the season, we run asparagus in that plant, I was thinking as the asparagus got over we would get ready for peaches and the time was getting pretty short, and sooner or later Mr. Wilbur said, ‘Well, we aren’t going to have these machines available for you to put in up here,’ to which I was greatly relieved. And as I said a minute ago I think Mr. Wilbur was extremely relieved. As a matter of fact, afterwards, I don’t know if it’s of any importance or not, but afterwards he told me that he was darned glad that he didn’t put these machines in our Plant 12, and I said I was very glad we didn’t either. As a matter of fact, I wrote a letter to our people saying that I thought that we ought to do something else.”

R. Vol. 6, pages 578-579.

And as established through Mr. Saxby's testimony California Packing Corporation used the knife pitter in the 1956 season. (581).

Libby, McNeill & Libby, one of the lessees, operated in the same manner as California Packing Corporation, as established by the testimony of Mr. Sigler, except for the use of three experimental type heads which were operated in Libby's plant under the auspices of FMC personnel. In the case of Libby the offer made by FMC was in the form of Exhibit AB-13. Mr. Sigler stated in this respect:

"A. The offer was made by FMC. When you say 'who,' I don't know who specifically, if that's what you are asking me.

Q. Do you have any acquaintance with Mr. Frank Fay?

A. Yes.

Q. Was he at all involved, to your knowledge?

A. Yes, it would have been Frank Fay at that time.

Q. I take it from your previous testimony that Libby did not accept that offer.

A. Not for the 300 heads, no, we did not.

THE COURT: Why not?

THE WITNESS: As of that time the contract actually was negotiated or set up in late 1955, October-November of 1955, and we couldn't be certain that the performance of it would give us the performance or work on the fruit that we wanted. It was developmental from our viewpoint. We were

just — didn't want to take the chance with them, putting them in.

THE COURT: You mean you wouldn't gamble on your pack?

THE WITNESS: That's it, in essence, yes."

R. Vol. 4, pages 403-404.

Mr. T. H. Richards in his deposition, Exhibit 98, Defendants' Exhibit AB-12, testified with respect to this venture:

"Those machines were in here, and we tried them out and they didn't work, so we replaced them and used the old type machine. There was no charge or no records of that." Exhibit 98, page 41.

Any payments made by the Bercut-Richards Company for the pitters in 1956 were for the knife pitter. Exhibit 98, pages 47-48.

The 300 heads as this record shows were not possible of performance at the start of the 1956 cannery season because no head was in existence capable of cannery use.

In the case of *Johnson v. Atkins*, 53 Cal.2d 430 (1942), the Court stated the doctrine of frustration is well stated in *Straus v. Kazemekas*, 100 Conn. 581:

". . . The doctrine of frustration is well stated in *Straus v. Kazemekas*, 100 Conn. 581 [124 Atl. 234, 238] where the court says: 'Where from the nature of the contract and the surrounding circumstances the parties from the beginning must have known that it could not be fulfilled unless when the time for fulfillment arrived, some particular thing or condition of things continued to exist so that they must be deemed, when entering into the contract, to have contemplated such continuing existence as the

foundation of what was to be done; in the absence of any express or implied warranty that such thing or condition of things shall exist the contract is to be construed as subject to an implied condition that the parties shall be excused in case, before breach, performance becomes impossible or the purpose of the contract frustrated from such thing or condition ceasing to exist without default of either of the parties. 12 A.L.R. 1275.'” (Pages 431-432).

There is clearly no warranty here with respect to the leases or orders entered into with respect to the 300 heads. They were all conditioned upon the success of the further testing and experimentation to be undertaken in Australia. All of the parties knew of the ability to substitute the knife head in the event the conditions were not met. It is apparent that the parties, at least some of them, were advised that the conditions were not met before the 1956 season and those who were not so advised immediately became cognizant of the fact at the start of the 1956 pitting season. Under these conditions it is apparent that the contracts were void and unenforceable within the principles stated in *Johnson v. Atkins*, 53 Cal. 2d 430 (1942), where at page 433 it is stated:

“ ‘ Throughout the line of cases, now a long one in which it has been held that certain events frustrate the commercial adventure contemplated by the parties when they made the contract, there runs an almost continuous series of expressions to the effect that such a frustration brings the contract to an end forthwith, without more and automatically. They are too numerous to be cited exhaustively, but there are few expressions to the contrary and none in recent cases.’ ”

What is meant in the law with respect to impossible of performance is well settled in this State in the case of

Oosten v. Hay Haulers Etc. Union, 45 Cal.2d 784 (Dec. 23, 1955), which states:

“[1] Impossibility of performance is a defense and the burden of proof in establishing it rests on defendant. (*Hensler v. City of Los Angeles*, 124 Cal. App.2d 71, 83 [268 P.2d 12]; *Paramount Pictures, Inc. v. Sparling*, 93 Cal.App.2d 768 [209 P.2d 968]; *McCulloch v. Liguori*, 88 Cal.App.2d 366 [199 P.2d 25]; *Lloyd v. Murphy*, 25 Cal.2d 48 [153 P.2d 47].) [2] “ “Impossibility” is defined in section 454 of the Restatement of Contracts, as not only strict impossibility but as impracticability because of extreme and unreasonable difficulty, expense, injury, or loss involved. [3] Temporary impossibility of the character which, if it should become permanent, would discharge a promisor’s entire contractual duty, operates as a permanent discharge if performance after the impossibility ceases would impose a substantially greater burden upon the promisor; otherwise the duty is suspended while the impossibility exists. (Restatement of Contracts, § 462.)’ . . .”

Thus, the very doctrine relied upon by this Court in the *Amerio* case within the “if” provision of the offer, leases or contracts, the holding of public use if based upon these offers, orders, or conditional leases, obviously fails. Even if viewed prior to the statutory period the contracts were within the above holdings either entirely void or unenforceable throughout that period of time and in fact throughout the period of the entire existence of said offers or leases because the fact remains as within the *Amerio* case, that there was no fully operative machine capable of carrying out the Boyce invention in existence prior to the critical date.

The Court in Finding 40 stated the large number of Model 300 machines and this must refer either to the

number of machines defined in the offers or the leases or orders, or the number of machines which were experimented with during the 1956 pitting season. One guess is as good as another as to what Finding 40 refers to. The "why" of the number of such machines is fully set forth in this record and there is no contrary evidence.

It is fundamental in cases involving the question of experimentation vs. public use that the facts surrounding each case are controlling and that the character of the experimentation or testing is dependent upon the particular facts of the case as viewed from the evidence submitted. If it requires six years to test a roadway to determine whether it meets the conditions for which it was designed and the tests were actually experimental in character the *Elizabeth v. Pavement Co.* case establishes that that is justifiable experimentation and not public use. There is no case to the contrary of this general rule.

In this case we are dealing with the peculiarities of the canning industry with respect to the development of an invention which must meet the peculiarities of this particular industry. Wilbur, Vol. 3, page 317.

The practice in this industry has been and still is to determine whether or not the development is susceptible of use under commercial environments. Wilbur, Vol. 3, page 318. The real test which the development must meet is that it will operate when used by regular operating personnel and not expert engineers or under the supervision of the inventor. Wilbur, Vol. 3, page 318.

Because of the variations in fruit, operating conditions, and even the variations found in the operation of the same machines in different plants of the same company, multiple installations are required. Vol. 3, pages 320-325. In this regard the testimony of Mr. Wilbur

given in Volume 3, pages 320-321 establishes the conditions which must be met in this are in bringing an invention to perfection for commercial use. Thus, Mr. Wilbur testified:

“A. I believe I said put out into canneries and operated to see whether they would perform under the control of the cannery operator. But that is not in itself sufficient in all cases, because of the many districts in which fruit is grown and the characteristics of fruit in these districts are such that operation of a group of machines in a single cannery is frequently not sufficient to prove that trouble will not be experienced, and that therefore the machine has been perfected, if it is operated in other canneries and on fruit grown in other districts.

For example, in cling peaches there are something over forty varieties of cling peaches, each of which have their different characteristics. There are I don't know how many agricultural production areas, but they extend all the way from the San Joaquin Basin up to the northern part of California in the coastal regions, and the properties of these peaches are quite different.

Therefore, the requirement exists, in order to prove perfection and prove completion of a development, to operate multiple installations of multiple machines. Even single machines in separate installations are not sufficient. And this is imperative in a development involving the risk capital that is involved in one like coming out with a new peach-pitter.”

It remains, however, that these machines which were operated experimentally in bringing this invention to perfection during the 1956 pitting season no matter how

many, cannot act to prove public use because all of this activity took place within the statutory period and after the critical date.

Finding of Fact 38 if it means that any canner paid for the use in the 1956 season for the Model 300 machines is clearly contrary to the record. If it means the sum of FMC customers billed for the lease rentals on pitters and who paid rentals to FMC under the leases it is not contrary to the record. The facts of this case clearly establish that no lessee or operator of the 300 pitter paid for any use of those devices during the 1956 pitting season. Finding of Fact 38 does not find what lease rentals were paid or upon what type of pitter the lease rentals were paid. Further, all activities with respect to these lease payments occurred within the statutory period and could not be considered to have been a public use. The evidence, however, in this regard is clearly insufficient within *Tucker Aluminum Products, Inc. v. Grossman*, 9 Cir., 312 F. 2d, 293 as establishing a public use and certainly cannot be considered to meet the burden of proof required to establish public use. A review of the canners who operated during the 1956 pitting season establishes, through the positive testimony of each of these witnesses, that no payment was in fact made by any canner for the 1956 pitting season operation of the 300 pitter head. In the Bercut-Richards Packing Company operation Mr. T. H. Richards, Jr. testified:

“MR. T. H. RICHARDS, JR.: Those machines were in here, and we tried them out and they didn’t work, so we replaced them and used the old type machine. There was no charge or no records of that.”
Exhibit 98, page 41.

It is a fact that Bercut-Richards Packing Company in the 1956 season used the knife pitters and that no payment was made for any operation by that Company other than for the use of the knife pitters. With respect to the 300 pitters Mr. Richards, Jr., testified that the few peaches that went through the experimental machines were picked off the line, were bypassed and no records were kept of the peaches processed through such experimental machines, Exhibit 98, pages 41-42. Mr. Richards further testified with respect to the use that was had of these machines as follows:

“MR. T. H. RICHARDS, JR.: Actually, it cost Food Machinery money and cost us money installing them and taking them out and fooling around with them. That is why there was never any charge for any fruit that was run through. It was purely experimental. It didn't work, so they took them out.” Exhibit 98, page 43.

Mr. William D. Poggetto, president of Fruitvale Canning Company likewise testified concerning the intermittent operation of both the 300 head and the knife pitter because of the trouble had with pit fragments. Vol. 3, page 237. He further testified to the continuing experimentation of the 300 type head throughout the entire 1956 peach pitting season and the fact that FMC maintained a crew of mechanics and engineers at the plant constantly during this experimentation. Vol. 3, page 239. Mr. Poggetto testified that a token payment was made with respect to the leasing of the peach pitter which was returned with the result that there was no payment made for the use of either knife pitters or 300 pitters during the 1956 season:

“THE COURT: So nothing was actually paid under this contract dated December 28, 1955?

THE WITNESS: The net result, no, sir. We did make one payment which was then returned to us.

THE COURT: And you got it back?

THE WITNESS: Yes."

R. Vol. 3, 242.

There is no way of establishing what machine was used with respect to even this token payment. There are no records which would establish what machine was used by the Fruitvale Canning Company at any time during the 1956 season.

"A. We used one or the other or both for our entire operation in the 1956 peach season.

Q. But at any particular time you couldn't tell which machine was in operation?

A. No, sir."

R. Vol. 3, page 239.

Mr. David House, president of Frank M. Wilson Company, testified that no rentals were paid for the use of any FMC peach pitters by this Company in the 1956 season:

"MR. LYON: Q. Now, did the Frank M. Wilson Company use pitters of FMC in the 1956 season?

A. Yes.

Q. Did they pay for those pitters?

A. No. Only in worry."

R. Vol. 3, page 254.

The pitters as used by F. M. Wilson Company were likewise under the personal observation and control of FMC experts and mechanics. Vol. 3, page 257. The extent of

the use at F. M. Wilson Company during this 1956 season is accurately described by Mr. House. R. Vol. 3, page 257. It was at the F. M. Wilson Company plant at the end of the 1956 season that success was finally obtained in the operation of these machines. This was the only plant operating in the 1956 season where the continuous changes resulted in perfection of the Boyce invention. In this regard Mr. House testified:

“Q. You say later in the year they, by the succession of changes, that the machine began to operate successfully?

A. Very successfully, yes.

Q. And did the Frank M. Wilson Company use those machines during the next year?

A. Yes, we used them from then on out, the following seasons.

Q. And the following seasons did you pay for their use?

A. We paid for it in the '57 season, yes.

Q. But not in the '56 season?

A. Not in the '56.

R. Vol. 3, pages 258-259.

Mr. Alfred A. Morici, Production Manager of Hershel California Fruit Products Company, testified definitely with respect to the failure of the pitters to operate because of pit fragments. R. Vol. 3, pages 280-281. He also testified to the conversion of the pitters to the knife pitter, R. Vol. 3, page 281.

The fact that heads were being changed back and forth by engineering and service crews of FMC is established.

R. Vol. 3, page 286. The number of heads operated in this plant was brought about by the fact as testified by Mr. Morici:

“THE WITNESS: Oh, yes, yes. They made new heads, brought them up, tried them, went back and made some more new ones.”

R. Vol. 3, page 290.

The fact that Hershel paid nothing for the operation of the pitters in the 1956 season is established by Mr. Morici's testimony:

“Q. Did Hershel pay FMC anything for the operation of these machines in the 1956 season?

A. No. I sent them a bill, which I didn't collect, but I tried to get them to pay me.”

R. Vol. 3, page 290.

Mr. Fred H. Hauptman, Plant Manager for Tri-Valley Packing Association, testified that the machines used were the FMC rotary pitters which cut the pit out by a knife. R. Vol. 4, page 335. There is no record that Tri-Valley used the 300 rotary pitter at any time or paid any rental with respect thereto.

Mr. Charles A. Sigler, Assistant in the Production Department of Libby, McNeill & Libby, testified that Libby used only FMC rotary knife pitters in the 1956 season. R. Vol. 4, page 397. Although the 300 pitters were offered to Libby, McNeill & Libby they did not accept the offer, R. Vol. 4, page 404, and Libby paid the rental due for the knife pitter but for no other pitter.

Mr. Joseph James Annotti, President and General Manager of Fairview Packing Company, testified that the only pitter used by Fairview during the 1956 packing

season was the Pacific rotary knife pitter. R. Vol. 4, page 407. No 300 pitter was shown to have ever been at the Fairview Packing Company plant.

Mr. Paul Rea, President of U. S. Products, testified that they tried to use the 300 pitter in the 1956 season and that they converted all of their machines back to the knife pitters. R. Vol. 6, page 564. U. S. Products was relieved of all payments for the use of any pitters, even the knife pitters, as is evidenced from the letter Exhibit 73, R. Vol. 6, pages 566-568, and as stated by the following interrogation:

“THE COURT: Turned out it didn’t work, and it cost you money, and so you didn’t pay the rental, and between the two of you, you worked out an arrangement which adjusted your mutual interest?

THE WITNESS: Well said.

THE COURT: That’s about it?

THE WITNESS: That’s exactly it.” R. Vol. 6, page 570.

Mr. Donald Saxby, Manager of the California Division of California Packing Corporation, testified that California Packing Corporation in the 1956 season used only a knife pitter in the commercial pitting of peaches. R. Vol. 6, page 581, and although the 300 pitter was offered to them they elected not to use those machines in their pitting operation. R. Vol. 6, page 578.

The record in this case establishes that some canneries paid rental for the use of the Pacific rotary knife pitters which were under lease to those companies. The record is positive that no rental was actually paid by any company with respect to any use of the 300 pitters. The burden of proof established in *Tucker Aluminum Products, Inc. v. Grossman*, *supra*, is certainly not met by this evidence to establish a prior use prior to the pitting season

of 1956; nor is there any support in the record for Finding of Fact 38 unless it is specifically relegated to the use of the Pacific rotary knife pitter.

Finding of Fact 37 clearly establishes the fact that the pitters delivered during the 1956 pitting season were not satisfactory and did not overcome the existing problems which existed throughout this period of experimentation, i.e., the problems of pit yield and pit fragmentation.

The record in this case clearly establishes that no company, no lessee, or no operator could or did testify as to which pitting head, i.e., the knife head or the 300 head was in operation at any time during the 1956 pitting season. All payments which were actually received by FMC with respect to the leases, or orders for pitters during that season, were only with respect to knife pitters and the record is clear and absolute upon this point.

The District Court Erred In Failing To Determine The Question of Priority — 35 U.S.C., § 146.

In the Pretrial Order, paragraph 3, page 2 thereof, Tr. Vol. 1, page 120, it is provided:

“3. All the proofs of both parties on the issue of public use and/or on sale as contemplated in 35 U.S.C. Section 102(b) will be submitted for the Court's consideration before the submission of proofs on any other issues herein. This order is pursuant to the ruling of the Court to which ruling Plaintiffs except under the authority of *Sanford v. Kepner*, 344 U.S. 13 (1952).”

35 U.S.C. § 146, is a particular Statute with respect to interference proceedings arising in the Patent Office and in which proceedings the Patent Office has determined the question of priority of invention between rival claimants for a patent with respect to that invention.

Significant with respect to this section is the introductory clause thereof which provides:

“Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action . . . ”

In an interference proceeding as conducted in the Patent Office the only question determined is the question of priority and in this proceeding the Patent Office has uniformly taken the position that the question of public use is not before the Patent Office and is not determinable in that proceeding.

In an interference proceeding after the Patent Office has determined the question of priority a patent is issued to the party whom the Patent Office has found, through such proceedings, to be the prior inventor. This is provided by 35 U.S.C., § 135, which provides in part:

“ . . . and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. . . . ”

There is no provision in the Patent Office for withholding the issue of the patent to the person whom the Patent Office has adjudged to be the prior inventor pending the appeal procedures under Section 146. In accordance with this procedure Patent No. 3,075,566 was granted to defendants herein on January 29, 1963.

This patent now stands in this art not only as a scare crow therein but also as a direct deterrent to development in this art. It in effect estopped plaintiffs herein not only from the use of the invention defined therein but also stands as a means of preventing the use of this invention by the art, including those canners which this record shows cooperated so thoroughly with plaintiffs herein in the experimental development of the successful pitter

involving this invention. Thus, unless plaintiffs are willing to ignore this patent while at the same time asserting that it is an invention and patentable and taking the risk of an adverse decision on the question of patentability, plaintiffs herein are in the position that they and no one else in the art can utilize this invention. This fact is made evident from the frank position taken by defendants herein of their "dog in the manger position". In this regard defendants' counsel has stated:

"MR. FOSTER: This particular invention is not in use at this time by either party, . . ." R. Vol. 3, page 308.

Further the defendants have taken the position that under no circumstances are they interested in granting a license which would permit the invention to be utilized.

In this respect counsel has stated emphatically:

". . . my client is not agreeable to issuing a license to FMC."

R. Vol. 3, page 311.

With this record the District Court, in analyzing the position of the parties before the Court, has stated and it becomes apparent from that statement, that the Court's characterization of this matter as representing defendants' position as "a dog in the manger" is clearly apparent from the following:

"THE COURT: You correct me when I am in error, let me ask this: In effect, Mr. Lyon's position, Mr. Foster, would be that Filper Corporation, if it has the patent right to the method can adopt what might be broadly described as a dog in the manger attitude in order to keep FMC from utilizing their 300 machine with this type of head?

MR. FOSTER: Yes.

THE COURT: Even through Filper itself wants nothing more than the rather negative protection of eliminating competition of a type which is different than the equipment offered by Filper Corporation?

MR. FOSTER: Yes. This is generally true, Your Honor."

The purpose of the entire Patent Act as defined in our Constitution is to reward inventors who have advanced the arts and where it is shown that patents are being used not to advance the art but to restrain development therein the Court is in a position where it must look at the facts before it with reference to carrying forward the intent of the Constitution rather than to abort it. It is obvious here that within the findings of this Court, if they are interpreted as defendants must interpret them, that is, as established by this record, the Boyce invention was in the possession of FMC long prior to the Anderson application on which Patent No. 3,075,566 was granted, i.e., prior to August 6, 1956. We categorically state that under this situation and as Anderson did not prove any reduction to practice prior to August 6, 1956 before the Patent Office, upon proper determination of the issue of priority the Anderson patent, insofar as it claims the invention common to the parties here in question, would be void, requiring cancellation of the claims from the Anderson patent in question within the provisions of 35 U.S.C. § 135 which provides:

" . . . A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof

shall be endorsed on copies of the patent thereafter distributed by the Patent Office.”

Defendants’ position here, as evidenced in the Pretrial Order and their exhibits listed in conjunction therewith and which contemplated that this Court might under the provisions of the Pretrial Order, paragraph 3 above quoted, determine the question of priority, have listed no evidence which would in any way supplement the Patent Office record or could be relied upon to establish any reduction to practice by Anderson prior to August 6, 1956.

With this record the pertinency of the *Sanford v. Kepner* decision (344 U.S. 13, 97 L.ed 14) of the Supreme Court dealing with the question of the issues before the Court in an action brought under 35 U.S.C. § 146 becomes immediately apparent. The Supreme Court thus in the *Sanford v. Kepner* case, in reviewing the prior revised Statute, Section 4915, which in this respect was reenacted in 1952 as 35 U.S.C. 146, stated definitely the purpose of this provision of the law:

“The obvious purpose of the quoted part of RS § 4915 is to give a judicial remedy to an applicant who has been finally denied a patent because of a Patent Office decision against him and in favor of his adversary *on the question of priority*. When the trial court decides this factual issue of priority against him and thus affirms the refusal of the patent by the Patent Office, he has obtained the full remedy the statute gives him. *Only if he wins on priority may he proceed. . . .*” (Emphasis ours). *Sanford v. Kepner*, 344 US 13, 97 L.ed 15.

The question before the Supreme Court in *Sanford v. Kepner* was with reference to the validity of the patent which was issued to the successful applicant and as to whether or not the Court in such proceedings should or

could in that proceeding determine the question of patentability upon the basis of whether or not there was a patentable invention. There was a diversity of views as pointed out by the Supreme Court as to the obligations and ability of the Court to go ahead in an action brought under Section 146 of U.S. 35 or Section RS 4915 with respect to this determination and it was to settle this difference in views that the Supreme Court granted certiorari. 344 U.S. 14, L.ed 14. The Supreme Court in ruling upon this matter stated:

“ . . . No part of its holding or wording nor of that in *Hoover Co. v. Coe*, 325 US 79, 89 L.ed 1488, 65 S.Ct. 955, requires us to say RS § 4915 compels a district court to adjudicate patentability at the instance of one whose claim is found to be groundless. Sanford's claim was found to be groundless.”

The Supreme Court further stated:

“ . . . Here the very person who claimed an invention now asks to prove that Kepner's similar device was no invention at all because of patents issued long before either party made claim for his discovery. There is no real issue of invention between the parties here and we see no reason to read into the statute a district court's compulsory duty to adjudicate validity.” 344 US 16, L.ed 14.

Thus the Supreme Court has definitely read out of the section any duty and we might say any right of the Court to determine the question of patentability of the invention at least until the Court has determined the question of priority between the parties which is the major purpose as determined by the Supreme Court of the section in question. In each of the following cases it is recognized that the issue of priority is the issue before the Court in this type of action. The only diversity of ruling

on this point is as to the propriety or obligation of the Court to determine other issues after it has determined the issue of priority. See: *Hill v. Wooster*, 132 U.S. 693, 33 L.ed 502; *Turchan v. Bailey Meter Company* (D. C. Del, 1956), 19 F.R.D. 201; *Gold et al v. Gold*, 237 F. 84, 87 (C.A. 7, 1916); *Hansen v. Slick*, 216 F. 164 (D.C. W.D. Pa. 1914), Affirmed C.A. 3, 230 F. 627; *Heston v. Kuhlke*, 179 F. 2d 222 (C.A. 6, 1950); *Sperry Rand Corporation v. Bell Telephone Laboratories, Inc.*, 171 F. Supp. 343 (D.C.S.D. N.Y. 1959); *Sinko Tool & Mfg. Co. v. Automatic Devices Corp.*, 136 F. 2d 186, 189 (Cir. 2, 1943); and *Wiegand v. Dover Mfg. Co.*, 292 F. 255 (N.D. Ohio 1923).

Thus, in this case the Court in determining the question of public use prior to the determination of the question of priority has proceeded contrary to the directions of the Supreme Court which definitely states:

“ . . . Only if he wins on priority may he proceed. . . ”
Sanford v. Kepner, *supra*. The propriety of this holding of the Supreme Court in construing the section under which this action is brought is clearly emphasized by the facts as hereinabove recited wherein the defendants in this action are shown to be using a probably invalid patent under the peculiar circumstances of this case to deter and stop development in this art and to prevent the use of the very method involved here for the pitting of peaches.

This Court further clearly erred in accepting depositions and permitting the same to be used where it was definitely shown that the requirements of the Federal Rules of Civil Procedure had not been followed. The Court permitted the use of the depositions where the depositions had not been signed by the witness whose deposition was taken and there was no waiver of the

rule with respect thereto. Rule 30 of the Federal Rules of Civil Procedure, section (e) thereof provides:

“(e) Submission to Witness; Changes; Signing. When the testimony is fully transcribed the deposition shall be submitted to the witness for examination and shall be read to or by him, unless such examination and reading are waived by the witness and by the parties. . . .”

As heretofore shown the depositions in question were not submitted to the witness. Rule 30, section (e) also provides:

“. . . The deposition shall then be signed by the witness, unless the parties by stipulation waive the signing or the witness is ill or cannot be found or refuses to sign. . . .”

The depositions read and used in the evidence in this cause were not signed by the witness and with respect to the witness it was specifically shown that the witness himself declined to make any waiver and requested that he have the privilege of reading and correcting, if necessary, his deposition. There was no refusal of the witness to read the deposition as it was not even submitted to him for that purpose. The Federal Rules of Civil Procedure also require, and the purpose of this rule is obvious, that the parties who intend to rely upon such deposition give notice of filing of the deposition. Thus, Rule 31, section (c) provides:

“(c) Notice of Filing. When the deposition is filed the party taking it shall promptly give notice thereof to all other parties.”

Many depositions are taken on discovery in these cases on which there is no intention of either party to rely at the trial and obviously the purpose of Rule 31, section

(c) in providing for such notice of filing is to give all parties notice that the depositions have been filed and that it may be presumed that they will be used if otherwise qualified. No such notice of filing was given with respect to any of the depositions used in this cause. One of the depositions used was that of Mr. Curtis Paul Wilbur and the ruling of the Court with respect to this deposition is in Volume 2, page 130, and it was at that time pointed out to the Court that Mr. Wilbur had declined personally to waive the rules with respect to his reading and signing his deposition. The deposition was not used to refute or to attempt to impeach any of the testimony given by Mr. Wilbur but as a means of supporting the defendants' case in this cause of action. It is the position of plaintiffs that if the practice with respect to the use of such depositions is to ignore the Federal Rules of Civil Procedure and to permit depositions to be used in Court under the circumstances as hereinabove outlined no party appearing before the Court can know what evidence he must meet but he must assume in a trial of any action that the rules have no meaning and that the Court may proceed in total disregard of the positive requirements of the rules in considering evidence of the character here in question.

CONCLUSION

In this case it is clear that the plaintiffs herein were in possession of the invention long prior to the filing date, namely, August 6, 1956, of the invention by the patentee Anderson. This was conceded and stipulated to. It was conceded and stipulated to and there is no evidence to the contrary, that although the invention was shown to be operable, that is, that the method could be used to get a pit out of a peach, the method as it was reduced to practice developed certain problems, i.e., of pit fragmen-

tation and yield that must be remedied before the invention was capable of commercial application. It was conceded and stipulated that plaintiffs herein worked throughout the period from August of 1955 through the 1956 pitting season to perfect this invention and only then at the end of the 1956 pitting season had they overcome those problems of pit fragmentation and yield necessary to the commercial use of this invention.

It is a fact that plaintiffs herein, before they undertook what subsequently proved to be a mammoth development expense, i.e., eventually \$808,907.66 under a condition of confidence and with explanation of the fact that further experimental work was required to bring the method to commercial application, exhibited prototypes involving the invention to canners for the two purposes of determining whether or not the peach halves as produced would be acceptable to the trade in appearance and whether or not the canners would be interested in using the invention and the extent to which they might expect the said method to be used in the event they were successful in perfecting the invention prior to the undertaking of the major portion of the expense subsequently involved in the perfection of this invention. It was conceded that this demonstration under these facts did not constitute a public use. Plaintiffs sought from these canners who were then users of the prior knife pitter a determination of the extent to which they might use the new method were it developed and for this purpose offered to supply the canners with pitters for the subsequent 1956 season and did so in the form of standard leases and/or orders conditional upon the perfection of the invention with the understanding that if the invention was not perfected for use in the 1956 season the knife pitter would be used as a substitute therefor. No actual enforceable contract to supply the new form of pitter for the 1956 season was in any case entered into between

plaintiffs and/or the canners and this is shown not only by the testimony of the witnesses themselves as to their understanding but by the subsequent events.

If facts of this character are prohibited within the provisions of 35 U.S.C. § 102(b), it is evident that one seeking to develop an invention for use in a field like that under consideration must proceed substantially in the dark. He would not be permitted to determine from his possible customers whether or not the invention would be acceptable to those customers. He could not determine the extent to which the invention might be used as a preliminary to the expenditure of hundreds of thousands of dollars in perfecting an invention and any such premise or ruling is obviously contrary not only to the prior rulings of this Court but those of the Supreme Court in the United States which recognize from a standpoint of policy and the law the necessity of and advisability of permitting one to perfect as far as possible his invention before he is required to apply for a patent. No one and in no cited decision that has been found by plaintiffs is there a decision which would deny under the premise of "prior public use" inventors or industry to proceed in the manner here shown.

It is respectfully submitted that the decision of the District Court in this matter must be reversed and that this cause must be returned to the District Court to determine that issue brought before it under this action, i.e., the determination of priority of invention between the parties.

Respectfully submitted,

LYON & LYON
LEWIS E. LYON

*Attorneys for Appellants and
Cross-Appellees*

CERTIFICATE

I certify that, in connection with the preparation of this brief, I have examined Rules 18, 19 and 39 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

By

Lewis E. Lyon

APPENDIX A

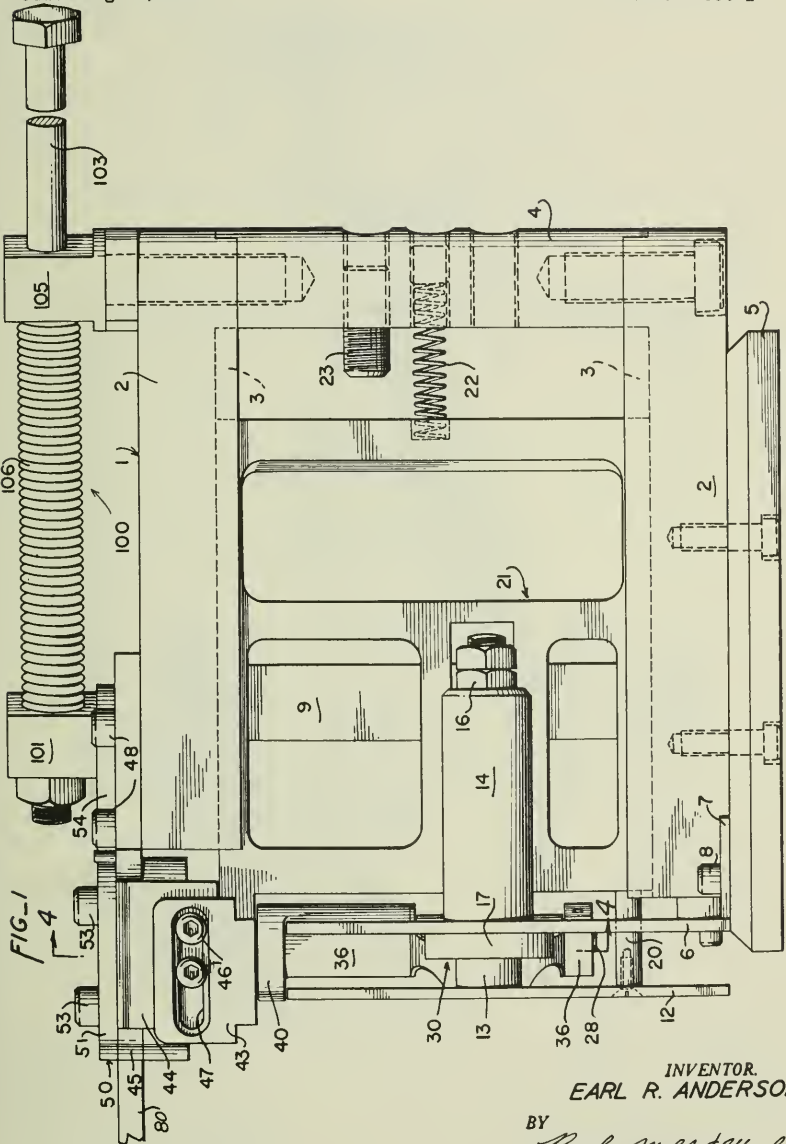
Jan. 29, 1963

E. R. ANDERSON
PEACH PITTING METHOD

3,075,566

Filed Aug. 6, 1956

5 Sheets-Sheet 1



INVENTOR.
EARL R. ANDERSON
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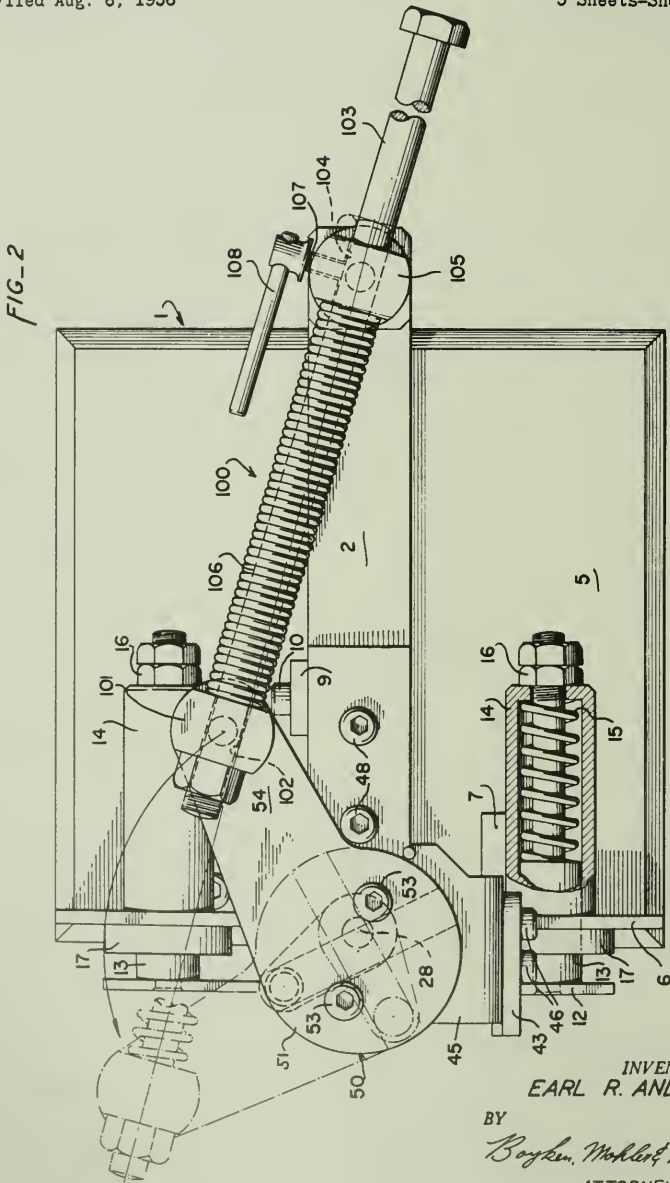
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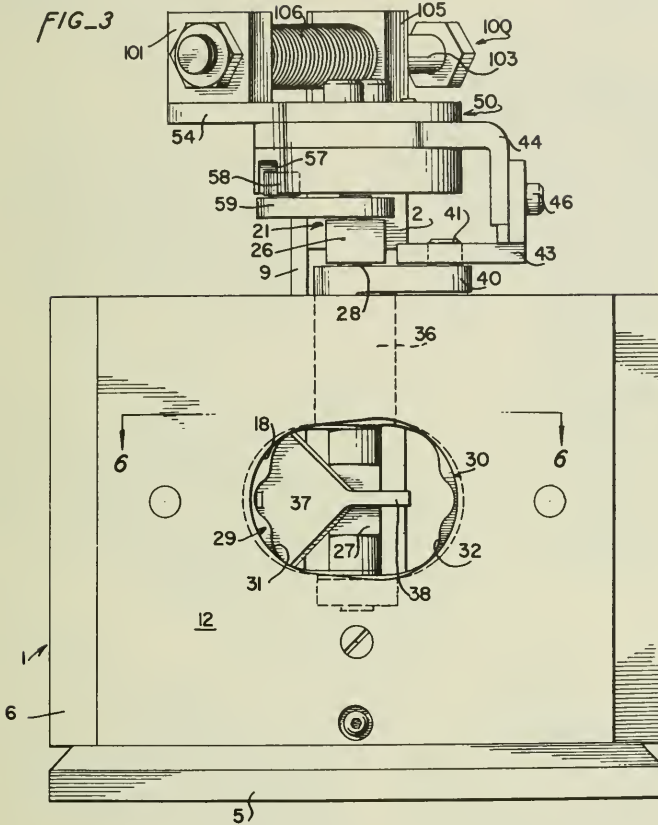
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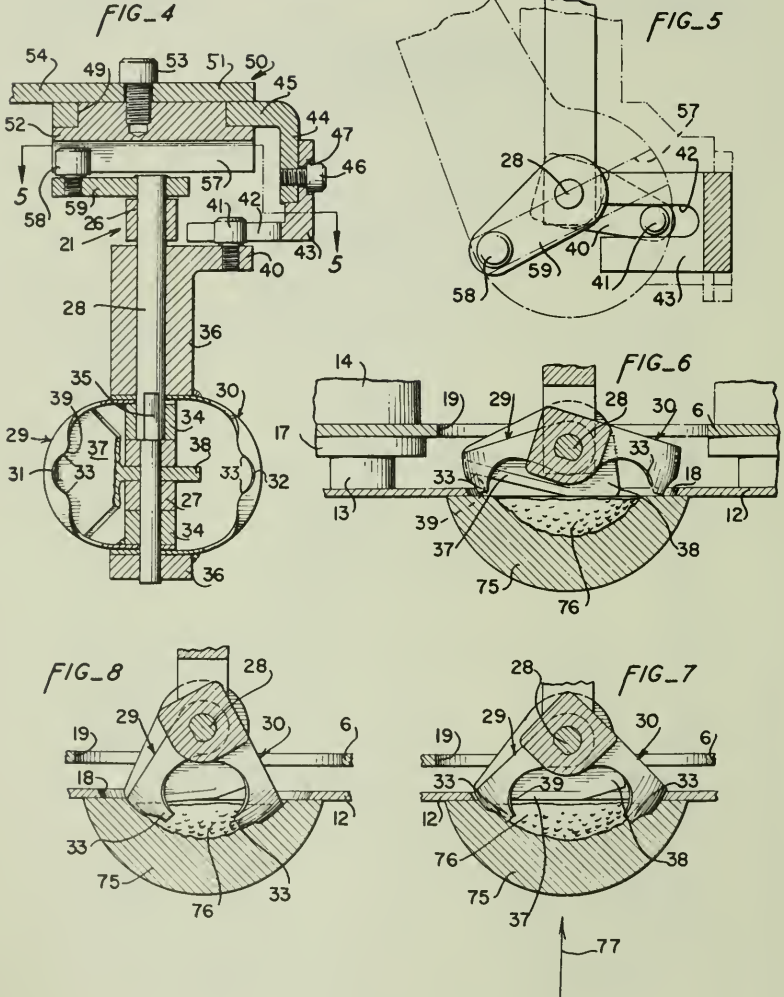
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5 Sheets-Sheet 4



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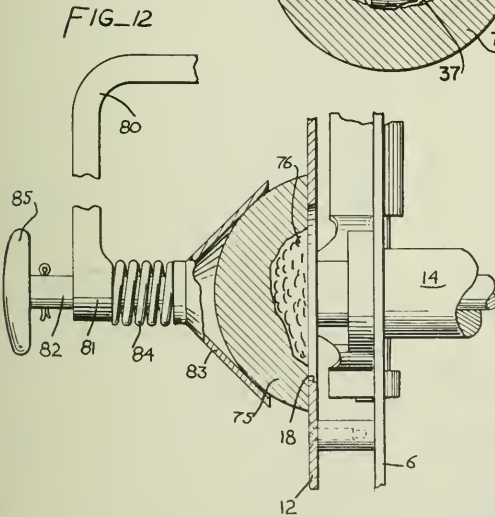
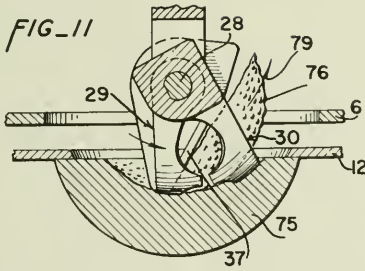
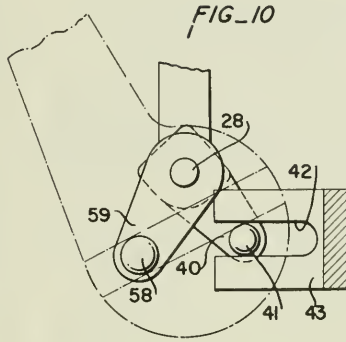
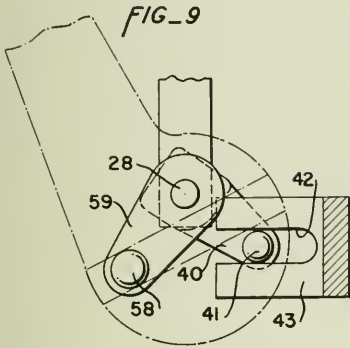
Jan. 29, 1963

E. R. ANDERSON
PEACH PITTING METHOD

3,075,566

Filed Aug. 6, 1956

5 Sheets-Sheet 5



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United States Patent Office

3,075,566

Patented Jan. 29, 1963

1

3,075,566

PEACH PITTING METHOD

Earl R. Anderson, Campbell, Calif., assignor to
Filper Corporation, Richmond, Calif.
Filed Aug. 6, 1956, Ser. No. 602,096
7 Claims. (Cl. 146—238)

This invention relates to the pitting of clingstone peaches and, more specifically, to the removal of pits from the peach halves to which the pits may be adhered. The apparatus hereinafter described bears some features that are shown in my copending application, Serial No. 244,795, filed September 1, 1951, now Patent No. 2,775,278.

One of the objects of the invention is the provision of a clingstone peach pitter that will quickly remove the pits from the peach halves with which they are connected by moving each pit bodily out of the pit cavity in the peach half along a path substantially coincidental with the contour of the pit cavity.

Another object of the invention is the provision of a method of removing the half pits from clingstone peach halves by severing the fibers connecting the pit in each half with the flesh of the latter substantially at the adjoining surfaces of the pit and pit cavity by moving the pit along an arcuate path that is substantially in continuation of the curvature of the surface of the pit cavity.

Various prior art devices have been proposed for pitting whole peaches and like fruit of the clingstone variety, a recent development being shown in U.S. Letters Patent No. 2,664,127, issued December 29, 1953 to Joseph Perrelli, in which the pit is held and both peach halves are separated therefrom in one operation without cutting the pit from the fruit. In some cases, however, the fruit as it comes from the orchard may have a defective pit or a pit that is split, and which cannot be held by such apparatus. In such cases removal of a pit from one peach half at a time may be necessary.

Many types of apparatus for cutting a pit from a peach half have been proposed. However, it has been found desirable to separate the pit from clingstone peaches by tearing or rupturing the fibers that adhere the pit to the peach in order to prevent the loss of flesh, and also, it has been found that the flavor of peaches pitted in this manner is superior to those in which the pit and flesh adhering thereto has been completely cut from the peach half.

It is therefore another object of this invention to provide a novel method for pitting peach halves which includes rupturing a portion of the fibers which attach the pit to the peach.

Still another object of this invention is the provision of apparatus for performing the above method.

A further object of this invention is the provision of apparatus for imparting a shock to a pit adhered to a peach half while supporting the pit in a manner to eject the same from the peach half.

Yet another object of this invention is the provision of a method of pitting peach halves by partly cutting and partly rupturing the fibers adhering the pit to the peach half.

Other objects and advantages will become apparent from the description taken in connection with the accompanying drawings, in which:

FIG. 1 is a side elevational view, in full size, of the major portion of the apparatus of this invention;

FIG. 2 is a top plan view of the apparatus of FIG. 1;

FIG. 3 is a front end elevational view of the apparatus of FIG. 1;

FIG. 4 is a sectional view taken substantially along line 4—4 of FIG. 1;

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FIG. 5 is a sectional view taken substantially along line 5—5 of FIG. 4 and showing the position of the driving mechanism of the apparatus at its original position;

FIG. 6 is a sectional view taken substantially along line 6—6 of FIG. 3 and showing the position of pitting elements as related to the driving mechanism of FIG. 5;

FIG. 7 is a sectional view similar to FIG. 6 showing the position of the pitting elements during the first step of the pitting operation;

FIG. 8 is a sectional view similar to FIG. 6 showing the position of the pitting elements at the end of the first step of the pitting operation.

FIGS. 9 and 10 are sectional views similar to FIG. 5 showing the position of the driving mechanism corresponding to the positions of the pitting elements of FIGS. 7, 8, respectively; and,

FIG. 11 is a sectional view similar to FIG. 6 showing the position of the pitting elements during the final pitting operation; and

FIG. 12 is a partly elevational, partly sectional view of a portion of the apparatus of FIG. 1, showing peach holding means.

In detail, the apparatus of this invention comprises a frame, generally designated 1 (FIGS. 1, 2, 3), composed of a pair of generally horizontal, spaced guide members 2 having oppositely inwardly opening grooves 3 therein. Members 2 are rigidly secured in said spaced relation by a back frame member 4 (FIG. 1) and are rigidly fixed to a horizontal base plate 5. At the forward end of the base plate 5 the same is provided with an upstanding fixed plate 6 which may be rigidly secured to base 5 as by brackets 7 and screws 8. Since the upper end of plate 6 is not secured to upper guide member 2, the forward ends of said guide members may be held in spaced relationship by a side strap 9 (FIGS. 1, 2, 3) secured thereto by screws 10.

Mounted forwardly of fixed plate 6 and in a spaced, parallel relation thereto is a movable plate 12. Plate 12 is horizontally reciprocable with respect to plate 6 since it is mounted on a pair of horizontal rods 13 which extend into spring units 14 secured to the rear side of plate 6. Springs 15 (FIG. 2) in each spring unit 14 urge plate 12 away from plate 6 to the extent limited by stop nuts 16 threadably received on rods 13. The inward movement of plate 12 toward plate 6 against the force of springs 15 is limited by spacer collars 17 surrounding rods 13 between plate 12 and plate 6. Plates 12 and 6 are formed with horizontally aligned openings 18, 19 respectively (FIGS. 3, 6), for a purpose to be described. Opening 19 may be formed slightly larger than opening 18 and the latter is a little larger than the largest pit expected to be encountered.

Extending rearwardly from movable plate 12 through an opening in plate 6 is a push rod 20 (FIG. 1). The forward end of push rod 20 is secured to plate 12 and its rearwardly directed end is adapted to engage the front end of a slide member 21 which is slidably received in grooves 3 in guide members 2. Slide member 21 is urged to its forward position (to the left in FIG. 1) by a helical spring 22 interposed between the rear end thereof and back member 4. The rearward travel of slide member 21 is limited by an adjustable screw 23 projecting forwardly from back member 4. The forward movement of member 21 is, of course, limited by stop nuts 16 in the same manner as movable plate 12. It will be noted that the original or forward position of member 21 with respect to plate 12 may be adjusted by interposing push rods 20 of different lengths therebetween.

The forward end of slide member 21 is formed to provide a pair of vertically spaced bearings 26, 27 (FIGS. 3,

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4) in which the vertical drive shaft 28 is journaled. Shaft 28 is free to rotate in bearings 26, 27 and moves longitudinally of frame 1 with slide member 21. It will be noted from FIG. 6 that when slide member 21 is in its original or forward position, shaft 28 is positioned in the space between plates 6 and 12.

In FIG. 4 it will be seen that the lower end of shaft 28 carries a pair of arcuately formed, opposed pit holding elements or blades 29, 30. Blades 29, 30 are substantially U-shaped and their forwardly directed edges are sharpened to provide cutting edges 31, 32. Said cutting edges may be formed to the somewhat sinusoidal curve shown with their central portions recessed to provide a pair of nibs 33 on either side thereof. Preferably edges 31 are sharpened substantially throughout their arcuate extent.

The nibs 33 in effect form two portions which are the leading cutting edges of blades 29, 30. As will appear later, when blades 29, 30 cut into the flesh of a peach half adjacent the pit they leave an uncut area at the recess between the nibs 33.

Blade 29, which will hereinafter be referred to as the ejector blade, is provided at its inner ends with a pair of opposed bosses 34 having aligned openings for receiving the lower part of shaft 28 therethrough. Bosses 34 are secured as by welding to blade 29 and a flat 35 may be formed on shaft 28 for securing one of said bosses thereto by means of a key or set screw. In this manner, blade 29 is fixed to shaft 28 for rotation therewith.

Likewise the inner ends or legs of blade 30, hereinafter known as the supporting blade, are provided with a pair of opposed bosses 36 (FIG. 4) which also have aligned openings for receiving shaft 28. Bosses 36 are secured as by welding to blade 30 and are rotatable with respect to shaft 28. In effect, as seen in FIG. 4, blade 29 may rotate with shaft 28 inside of the arcuate extent of blade 30.

Blade 29 is further provided with an integral web 37 (FIGS. 3, 4, 6) extending inwardly from the outer arcuate portion of blade 29 to a central flange 38 positioned between bosses 34 and rotatably received on shaft 28. The outer portion of web 37 is spaced rearwardly from cutting edge 31 where it is secured to the arcuate portion of blade 29. Web 37 and the arcuate portion of blade 29 thereby form a pocket 39 (FIGS. 4, 6) for a purpose to be described.

In FIGS. 3, 4, 5 it will be noted that the upper end of upper boss 36 is formed with a crank arm 40 having a follower 41 projecting upwardly therefrom at a point eccentric to shaft 28. Follower 41 is slidably received in an elongated, horizontal slot 42 formed in a fixed bracket 43. Bracket 43 is adjustably secured to the downwardly extending leg 44 of a horizontal bearing member 45 as by screws 46 extending through slot 47 in bracket 43 (FIGS. 1, 4). Bearing member 45 is secured to upper guide member 2 by screws 48 (FIGS. 1, 2). It will be noted that the relative angular position of crank arm 40 and therefore of supporting blade 30 may be adjusted by sliding bracket 43 forwardly or rearwardly and securing it in the desired position by screws 46.

It will be noted in FIG. 4 that the axis of the cylindrical bearing 49 of member 45 is positioned in the central vertical plane of the slide member 21. A driving head 50 comprising an upper disc 51 and a lower circumferentially grooved disc 52 is journaled for rotation on bearing surface 49 of bearing member 45. Said discs may be secured together by screws 53 (FIGS. 1, 2) and are provided with a crank arm 54 for rotation head 50 in bearing member 45. The underside of disc 52 is provided with a horizontally elongated slot 57 (FIGS. 2, 4, 5) which slidably receives a follower 58 carried by a crank arm 59. Arm 59 is pinned to the upper end of shaft 28 for rotation therewith and follower 58 is eccentric with respect to said shaft. Rotation of driving head 50 by arm 54 thereby rotates shaft 28 through slot 57, follower 58, and crank arm 59. In this manner, ejector blade 29 may be rotated independently of supporting blade 30.

The drive for head 50 and thereby blade 29 is had through a trigger mechanism, generally designated 100, shown in FIGS. 1, 2, and 3. Swingably secured to the end of crank arm 54 remote from head 50 is an upstanding boss 101 having a horizontal aperture 102 (FIG. 2) therethrough for receiving one end of an elongated rod 103. The other end of rod 103 extends through an aperture 104 in a similar boss 105 swingably mounted on the rear end of upper guide member 2. A helical compression spring 106 surrounds rod 103 and abuts bosses 101, 105 at opposite ends.

Trigger mechanism 100 may be cocked by pulling rod 103 rearwardly and compressing spring 106 to the position shown in solid lines in FIG. 1. A set screw 107, provided with a handle 108, is threadedly received in boss 105 and projects into aperture 104 and may be tightened to secure rod 103 in the cocked position. Upon release by withdrawal of screw 107 spring 106 will forcibly and rapidly snap arm 54 and therefore head 50 to the dot-dash line position of FIG. 2, thereby imparting a rapid rotation to ejector blade 29 through slot 57, follower 58, crank arm 59 and shaft 28. This motion transmitted to blade 29 is in effect a shock or rapid blow, for a purpose to be described.

In operation, the half 75 (FIGS. 6, 7, 9 and 12) of a peach which has been bisected along its sutural plane is presented to the forward face of movable plate 12 with the pit 76 adhering to said peach half arranged generally centrally of opening 18 and being exposed therethrough. In this position, it will be noted that the sutural plane of the peach half and the pit corresponds generally to the plane of movable plate 12. The peach half 75 is then urged toward plate 12 along the central axis of peach half 75 and pit 76 normal to their sutural plane.

The apparatus shown in FIG. 12 may be provided for the above purpose. A bracket 80 (FIG. 1) extends outwardly and downwardly from member 45 and is provided with a bearing 81 (FIG. 12) at its lower end. Bearing 81 is aligned with the aforementioned peach axis and has a shaft 82 slidably mounted therein for reciprocation along said axis toward and away from plate 12. Shaft 82 carries a peach supporting cup 83 at its end closest to plate 12 and a helical coil spring 84 may be interposed between said cup and bearing 81 for yieldably urging the cut face of a peach half 75 supported in cup 83 into engagement with movable plate 12. A knob 85 may be provided on the opposite end of shaft 82 by which cup 83 may be retracted for feeding and ejecting peach halves to and from said cut. The device of FIG. 12 thereby provides means for supporting or holding the peach half during the pitting operation to eliminate the possibility of an operator's hands coming too close to the pitting knives for safety.

At the first or original position shown in FIG. 6 it will be noted that the projecting nibs 33 of the cutting blades 29, 30 are adjacent the flat surface of the peach half 75 and just outside the ends of pit 76. The corresponding position of the elements of the mechanism for driving pitting elements 29, 30 is shown in FIG. 5.

Movable plate 12 is then urged toward fixed plate 6 by pressing on peach half 75 in the direction indicated by arrow 77 in FIG. 7. If desired, this may be done by spring 84 of holder 83, or manually. This rearward movement of plate 12, is, of course, limited by collars 17 (FIGS. 2, 6). In moving rearwardly plate 12 drives slide member 21 back against the force of spring 22 (FIG. 1) through push rod 20. Slide 21 carries drive shaft 28 of the blades with it thereby displacing said shaft with respect to the other elements of the blade driving mechanism. Since followers 41 and 58 are prevented from any substantial rearward movement by slots 42 and 57 respectively, which are held stationary during the above movement, the effect of moving the shaft 28 rearwardly is to rotate crank arms 40 and 59 thereby closing blades 29, 30 respectively toward each other. Blades 29, 30 are

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closed to the position shown in FIG. 7 around opposite ends of pit 76 and ribs 33 actually cut into the flesh of peach half 75 adjacent said pit. The position of crank arms 40, 59 corresponding to this position of blades 30, 29, is shown in FIG. 9.

In the event the pit 76 is smaller than the largest pit that may be accommodated by the pitting elements 29, 30, the same may be further closed against the pit by grasping the rear of slide member 21 and retracting it further, independently of movable plate 12 to the position shown in FIG. 8. The corresponding drive mechanism position is shown in FIG. 10.

The configuration of cutting edges 31, 32 are such that the blades 29, 30 do not make a full cut around the pit 76, but the recess between ribs 33 leaves part of the pit adhered to the peach half. It is desirable that as much of the pit remain adhered to the peach as possible for the following pitting step consistent with relieving the edge of the pit and trimming the pit cavity.

It will be noted that ejector blade 29 has been rotated sufficiently to bring web 37 thereof into contact with the surface of pit 76 opposite peach half 75 (FIG. 7). One end of pit 76 is therefore received in the pocket 39 formed between the cutting edge of blade 29 and said web. Although the drawing discloses a half pit with web 37 in contact with the flat face thereof, it should be noted that the means here described will work as effectively in cases where a whole pit is adhered to a peach half. It may be necessary in such cases to form web 37 to a concave shape so that a configuration of pocket 39 more nearly approaches the shape of the end of the whole pit. However, this is not absolutely necessary as the end of the pit will be received and held in pocket 39 when formed as shown in FIG. 7.

At this point, the trigger mechanism 100 is tripped by withdrawing screw 107 and spring 106 forces arm 54 forward rapidly as described. The blow or rapid rotation thus imparted to pitting element 29 ruptures the remaining fibers that adhere pit 76 to peach half and shocks the pit loose from its cavity (FIG. 11).

It will be noted that supporting element 30 cradles the underside of the pit adjacent the flesh of the peach half during this final pitting step. Not only does blade 30 trim the portion of the pit cavity adjacent the sutural plane of the peach but it also acts to guide the pit through blade 30 and out of the pit cavity in the direction of arrow 79.

The cavity of a peach half pitted in accordance with the method and apparatus of this invention substantially retains the desirable characteristics of a rough, colored surface and yet is trimmed clean of pit fragments and damaged flesh. The apparatus of this invention, in effect, combines some of the best features of cutting and tearing the pit from a peach half. Although the invention has been described and illustrated in detail, such should not be taken as restrictive thereof since it is obvious that many modifications could be made therein without departing from the spirit and scope of the invention.

I claim:

1. The method of removing a pit from a peach half that comprises the steps of: supporting said peach half against movement and driving the pit therefrom along an arc that is substantially in continuation of the curvature of the convex outer side of said pit and which curvature

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substantially corresponds with that of the pit cavity in said half and guiding said pit along said arc during said driving thereof.

2. The method of removing a pit from a peach half that comprises the steps of: forcibly moving said pit relative to said half along an arc that is substantially in continuation of the curvature of the pit cavity in said peach half and guiding said pit along said arc.

3. The method of removing a pit from a peach half that comprises the steps of: supporting said peach half against movement and driving the pit therefrom along an arc that is substantially in continuation of the curvature of the convex outer side of said pit and which curvature substantially corresponds with that of the pit cavity in said half, guiding said pit along said arc during said driving thereof and at approximately the same time trimming the flesh from said pit cavity adjacent to the plane of the cut side of said half.

4. A method for pitting peach halves comprising the steps of: supporting the pit of a peach half adhered to the convex surface of said pit adjacent said peach half at one point adjacent the outer periphery of said pit, and forcibly and rapidly imparting a blow to said pit at a point opposed to said one point and generally toward said one point for rupturing the fibers adhering said pit to said peach half and for ejecting said pit from said peach half.

5. A method for pitting peach halves comprising the steps of: partially cutting the flesh of a peach half adjacent the pit adhered thereto at opposed points on said pit adjacent the plane of the suture thereof, supporting said pit at one of said points, and forcibly and rapidly imparting a blow to said pit at the other of said points toward said one point for rupturing the remaining, uncut fibers adhering said pit to said peach half and for ejecting said pit from said peach half.

6. A method for pitting peach halves comprising the steps of: supporting the pit of a peach half adhered to the convex surface of said pit adjacent said peach half at one point adjacent the outer periphery of said pit, forcibly and rapidly imparting a blow to said pit at a point opposed to said one point and generally toward said one point for rupturing the fibers adhering said pit to said peach half and for ejecting said pit from said peach half, and, simultaneously with the step of imparting said blow, trimming the surface of the pit cavity formed by ejection of said pit.

7. The method of removing a pit from its cavity in a peach half which comprises: supporting said peach half, applying an arcuate force to one edge of said pit adjacent one edge of said pit cavity, and guiding said pit adjacent an opposite edge of said pit cavity along an arc which is a continuation of the curvature of said cavity.

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